



IN THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF MINNESOTA

ECOLAB INC.,

Plaintiff,

v.

GILBERT INDUSTRIES, INC.,

Defendant.

Civil No. 3-94-1505

Honorable Judge Kyle
Magistrate Judge Mason

FINAL JUDGMENT

The parties having agreed to the entry of this Final Judgment, according to the terms contained herein, the Court hereby finds, orders, adjudges and decrees that:

Findings of Fact and Conclusions of Law

1. This Court has jurisdiction over the parties to this action and over the subject matter of the pleadings. Venue is also proper in this forum.
2. Plaintiff, Ecolab Inc. ("Ecolab"), is a Delaware Corporation having its principal place of business at Ecolab Center, St. Paul, MN 55102.
3. Defendant, Gilbert Industries, Inc. ("Gilbert"), is an Arkansas Corporation having its principal place of business at 5611 Krueger Drive, Jonesboro, Arkansas, 72401-6818.
4. Ecolab has sued Gilbert for patent infringement of U.S. Patent No. 5,365,690 and Re-Examination Certificate No. 3451 (collectively "the '690 patent"), by virtue of Gilbert's sale of its product line under the trademark "FLYING VENUS®".
5. This action was filed on November 22, 1994 and in response, Gilbert denied that Ecolab's patent was valid, denied that it infringed the '690 patent, and sought reexamination of Ecolab's patent in the U.S. Patent and Trademark Office. Gilbert sought to stay this

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OCT 16 1998
FILED
FRANCIS E. DOSAL CLERK
JUDGMENT ENTD.
DEPUTY CLERK

1998

action in favor of the re-examination proceeding in the U.S. Patent and Trademark Office challenging Ecolab's patent, and as a result this action was stayed on November 13, 1995.

6. In the re-examination proceeding, the U.S. Patent and Trademark Office could only address "new issues" of patentability with respect to the original patent claims. However, with respect to re-examination claims 25 and 26, which were newly submitted during the proceedings in the U.S. Patent and Trademark Office, the Patent Office considered these claims against all prior art and was not limited to only considering new issues of patentability.
7. The U.S. Patent and Trademark Office concluded that Ecolab's patent claims subject to the re-examination proceeding were patentable and that newly presented claims 25 and 26 were patentable as submitted without further amendment.
8. Subsequent to the re-examination proceeding, Gilbert continued to assert that the claims of the '690 patent were not infringed by Gilbert, arguing that certain statements made in the patent's specification and in the file history should be read into the language of the patent's claims as specific claim limitations.
9. Gilbert filed a motion for summary judgment pursuing these and other arguments, which was briefed and argued before United States Magistrate Judge John M. Mason. On June 16, 1998, Magistrate Judge Mason issued his Report and Recommendation denying Gilbert's summary judgment motion.
10. Gilbert objected to the Report and Recommendation, and the parties fully briefed the issue before this Court.
11. This Court conducted a de novo review of the proceedings and adopted the Report and Recommendation and denied Gilbert's motion for summary judgment on August 11, 1998.
12. In denying Gilbert's motion, this Court concluded, at page 9 of the Report and Recommendation, that "[n]o special meaning is claimed for any of the terms in the patent,

so the words should be given the ordinary and common meaning by which they would be understood by a person skilled in the art".

13. Consequently, the plain meaning of the claims controls and it is improper to insert further limitations which do not explicitly appear in the text of the claims.
 14. In view of the proceedings in the Patent and Trademark Office and before this Court, the Court construes the claims of the Ecolab '690 patent to have no different meaning than their plain, ordinary language presents and rules that the claims are not subject to further limitations not appearing in the claims.
 15. Consequently, the Court finds and concludes and Gilbert agrees that its "Flying Venus" products which it has heretofore manufactured, infringe Ecolab's '690 patent.
 16. Based upon the recommendation, pleadings and the proceedings before this Court, the Court finds and concludes and Gilbert agrees that the '690 patent is a valid patent.
 17. This Court finds and concludes and Gilbert agrees that the invention of the '690 patent is a pioneering invention entitled to a broad scope of equivalents.
 18. Subject to the additional conditions in the following paragraph, Gilbert agrees that as of the date of this Final Judgment, it will not make, use, sell, offer for sale, or import an insect trap product that uses an attractive pattern of light displayed on a wall, vertical mounting surface, or equivalent surface above the trap.
 19. Any trap that does not direct a display of light of more than 3.5 footcandles of total reflected and radiated light upon the wall, vertical mounting surface, or equivalent surface, above the trap is excluded from the injunction of this judgment. Conversely, a trap of the general configuration of the Gilbert FLYING VENUS® or the Ecolab STEALTH® which creates a display of light of more than 3.5 footcandles of total reflected and radiated light, regardless of the specific amount of each individual component of light, upon the wall, vertical mounting surface, or equivalent, above the trap falls within the scope of Ecolab's broad '690 patent claims.
-

20. Gilbert agrees not to assert that it does not infringe the '690 patent by virtue of an argument that the claims are limited, beyond the literal wording of the claims, to some structure, limit, value, or the like, from the '690 patent or application history, including re-examination history, and prior art, including, but not limited to, such alleged limitations as:
- a) a specific angle for the internal geometry of a trap;
 - b) a specific amount of light that forms the pattern of light adjacent the trap;
 - c) the color or degree of reflectiveness of any of the internal surfaces of the trap;
 - d) the size, dimension or general shape of the trap; and/or
 - e) any other limitation, or narrowing definition, which contradicts the plain meaning of the words of the patent claims themselves or is not otherwise specifically recited in the claims.
21. Ecolab agrees that it will not charge any Gilbert product depicted in Catalog ILT Cat 1195 of Gilbert Industries, Inc. (Attachment A hereto), other than the 115GT/215GT "Flying Venus" Wall Sconce Fly Trap shown on pages 3 and 14 of Attachment A, as an infringement of the '690 patent.
22. If in violation of this judgment or of Ecolab's '690 patent, Gilbert makes, uses, sells, offers for sale, or imports a product which is the subject of litigation and which is not dismissed on a motion for summary judgment, Gilbert shall pay to Ecolab \$650,000.00 within thirty (30) days of the date upon which the time to file any dispositive motions elapses or within thirty (30) days of an adverse decision to Gilbert on any such summary judgment motion.
23. Gilbert must pay damages to Ecolab for the aforementioned infringement in the amount of \$800,000.00 in accordance with this Judgment as full compensation for its infringement in this action.
24. Gilbert is aware of the Federal Circuit Court of Appeals decision in *Foster v. Halco*, 20 U.S.P.Q. 2d 1241 (Fed. Cir. 1991), and hereby waives all right to contest validity of
-

Ecolab's '690 patent including in any proceedings of any type, involving its current products or any future products regardless of whether they are characterized as otherwise, new, different, not-infringing or the like, at all times in the future. Further, Gilbert will not assist others in any way, in any proceeding of any type, in contesting the validity of the '690 patent unless compelled to do so by a lawful Consent Order.

ORDER

This Court hereby orders that:

25. Gilbert, its agents, servants, employees, attorneys, assignees and all persons controlling or in active concert or participation with, through or under them are hereby enjoined:
 - a) from infringing any claims of U.S. Patent No. 5,365,690 and Re-examination Certificate No. 3451; and
 - b) from causing, inducing or contributing to the infringement of the same by others.
 26. The respective parties hereby shall pay their own costs, disbursements and attorneys' fees. The clerk is directed to enter this Final Judgment forthwith.
-

Date

10/16/98

for GILBERT INDUSTRIES, INC.

Steven H. Noll

Steven H. Noll
Hill & Simpson
85th Floor, Sears Tower
Chicago, IL 60606
(312) 876-0200

10-14-98

Norman Friederichs, 32,128
Friederichs Law Firm, plc.
1295 Fifth Street Towers
100 South Fifth Street
Minneapolis, MN 55402
(612) 333-0022

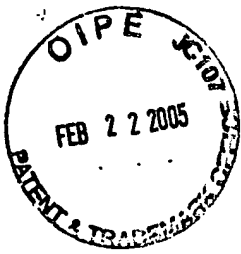
SO ORDERED

U.S. Judge Richard H. Kyle

for ECOLAB INC.

Douglas J. Williams 10/13/98

Douglas J. Williams, 117,353
Merchant, Gould, Smith, Edell, Welter & Schmidt
3100 Northwest Center
90 South Seventh Street
Minneapolis, MN 55402
(612) 332-5300



IN THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF NEBRASKA

DISTRICT OF NEBRASKA

OCT 17 1996

Norbert H. Ebel, Clerk

By _____

Civil No: 8:94CV601

ECOLAB INC.,

Plaintiff,

v.

Paraclipse, Inc.
d/b/a Paraclipse Automated
Insect Control Division

Defendant.

FINAL JUDGMENT

The parties having agreed to the entry of this Final Judgment, according to the terms contained herein, the Court hereby finds, orders, adjudges and decrees that:

Findings of Fact and Conclusions of Law

1. This Court has jurisdiction over the parties to this action and over the subject matter of the pleadings. Venue is also proper in this forum.
2. Plaintiff Ecolab Inc. ("Ecolab") is a Delaware Corporation having its principal place of business at Ecolab Center, St. Paul, MN 55102.
3. Defendant, Paraclipse Inc. ("Paraclipse") is a Nebraska Corporation having its principal place of business at 2271 29th Ave. E., Columbus, Nebraska 68601.
4. Ecolab has sued Paraclipse for patent infringement of U.S. Patent No. 5,365,690 ("690 patent"), by virtue of Paraclipse's sale of its product Insect Inn II.
5. This Court finds and concludes, and Paraclipse agrees, that the '690 patent is a valid patent.

6. This Court finds and concludes, and Paraclipse agrees, that Paraclipse has infringed the '690 patent by making, using and selling its "Insect Inn II" product.
 7. This Court finds and concludes, and Paraclipse agrees, that the invention of the '690 patent is a pioneering invention.
 8. Paraclipse must pay Ecolab the sum of \$40,000 within thirty (30) days of this Order as full compensation for the manufacture and sale of Insect Inn II products by Paraclipse and its distributors to date and as authorized by paragraph 9 hereof.
 9. Paraclipse may conclude its assembly and sales of Insect Inn II's only in accordance with the following conditions:
 - a) Paraclipse has no more than 600 Insect Inn II's in inventory which it may sell, to existing customers only, in the United States for sixty (60) days from the date of this Order.
 - b) Paraclipse may assemble and sell up to 5,700 Insect Inn II's to customers outside of the United States for 120 days from the date of this Order.
 - c) Paraclipse may make and sell replacement cartridges and parts for Insect Inn II's indefinitely in the U.S. and foreign countries.
 - d) Paraclipse agrees that it will not manufacture any further infringing products and will not sell any of its current inventory of products, inconsistent with the provisions of this paragraph.
-

ORDER

This Court hereby orders that:

10. Paracclipse; its agents, servants, employees, attorneys, assignees and all persons controlling or in active concert or participation with, through or under them, are hereby enjoined:

- a) from infringing any claims of U.S. Patent No. 5,365,690; and
- b) from causing, inducing or contributing to the infringement of the same by others.

11. The respective parties hereto shall pay their own costs, disbursements and attorneys' fees.

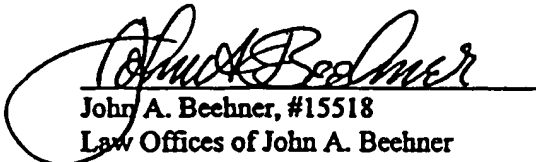
The clerk is directed to enter this Final Judgment forthwith.

SO ORDERED.

October 17, 1996
Date

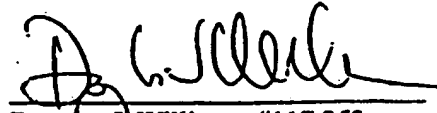

Judge Thomas M. Shanahan
United States District Judge

for PARACLIPSE INC.


John A. Beehner, #15518
Law Offices of John A. Beehner
502 Scoular Building
2027 Dodge Street
Omaha, NE 68102-1229
(402)341-2433

Date: 10-17-96

for ECOLAB INC.


Douglas J. Williams, #117,353
Merchant, Gould, Smith, Edell,
Welter & Schmidt
3100 Norwest Center
90 South Seventh Street
Minneapolis, MN 55402
(612)336-4632

Date: 10/15/96

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UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

ECOLAB INC.,

Plaintiff,

Vs.

Civil Action No. 98-2294 (MJD/JGL)

GARDNER MANUFACTURING CO., INC.,

Defendant.

SECTION I--Validity

1. Anticipation

Has Gardner proven by clear and convincing evidence that the subject matter covered by claims 18 or 26 of the '690 patent are anticipated by the prior art?

a) Claim 18 Yes _____ No X
b) Claim 26 Yes _____ No X

2. Obviousness

Has Gardner proven by clear and convincing evidence that the subject matter of claims 18 or 26 of the '690 patent would have been obvious to one of ordinary skill in the art as of January 4, 1992?

a) Claim 18 Yes _____ No X
b) Claim 26 Yes _____ No X

3. Indefiniteness

Has Gardner proven by clear and convincing evidence that claims 18 or 26 of the '690 patent are invalid for indefiniteness?

a) Claim 18 Yes _____ No X
b) Claim 26 Yes _____ No X

4. On Sale Bar

Has Gardner proven by clear and convincing evidence that claims 18 or 26 of the '690 patent are invalid because the subject matter of the claims was on sale prior to January 4, 1992?

a) Claim 18 Yes _____

No X

b) Claim 26 Yes _____

No X

SECTION II--Infringement:

1. WS-50

A) Has Ecolab proven by a preponderance of the evidence that the WS-50 contains each and every element of both claims 16 and 18 of the '690 Patent?

yes
(Yes or No)

B) Has Ecolab proven by a preponderance of the evidence that the WS-50 contains the equivalence of each and every element of both claims 16 and 18 of the '690 Patent?

yes
(Yes or No)

C) Has Ecolab proven by a preponderance of the evidence that the WS-50 contains each and every element of claim 26 of the '690 Patent?

yes
(Yes or No)

D) Has Ecolab proven by a preponderance of the evidence that the WS-50 contains the equivalence of each and every element of claim 26 of the '690 Patent?

yes
(Yes or No)

2. WS-75

A) Has Ecolab proven by a preponderance of the evidence that, when the metal plate does not cover the light bulb, the WS-75 contains each and every element of both claims 16 and 18 of the '690 Patent?

NO
(Yes or No)

B) Has Ecolab proven by a preponderance of the evidence that, when the metal plate does not cover the light bulb, the WS-75 contains the equivalence of each and every element of both claims 16 and 18 of the '690 Patent?

NO
(Yes or No)

C) Has Ecolab proven by a preponderance of the evidence that, when the metal plate does not cover the light bulb, the WS-75 contains each and every element of claim 26 of the '690 Patent?

YES
(Yes or No)

D) Has Ecolab proven by a preponderance of the evidence that, when the metal plate does not cover the light bulb, the WS-75 contains the equivalence of each and every element of claim 26 of the '690 Patent?

YES
(Yes or No)

SECTION III--Inducement

Has Ecolab proven by a preponderance of the evidence that Gardner actively induced its customers to use the WS-75 with the metal plate raised, and would such use infringe claims 18 or 26 of the '690 patent?

| | | |
|-------------|-----------|-------------|
| a) Claim 18 | Yes _____ | No <u>X</u> |
| b) Claim 26 | Yes _____ | No <u>X</u> |

SECTION IV – Contributory Infringement

Has Ecolab proven by a preponderance of the evidence that Gardner contributorily infringed claims 18 or 26 of the '690 patent?

a) Claim 18 Yes X No
b) Claim 26 Yes X No

SECTION V--Willfulness

Has Ecolab proven by clear and convincing evidence that Gardner willfully infringed the '690 patent?

NO
(Yes or No)

SECTION VI--Marking

Has Ecolab proven by a preponderance of the evidence that Gardner marked its products with U.S. Patent No. 4,876,822 for the purpose of deceiving the public?

NO
(Yes or No)

DATE: December 5, 2002

Foreperson: Sue Beaudette

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

Ecolab Inc.,

Plaintiff,

v.

SPECIAL VERDICT

Civil No. 98-2294(MJD/JGL)

Gardner Manufacturing Co., Inc.

Defendant.

We, the unanimous jury, answer the following questions:

1. What are Ecolab's damages for Gardner's sales of WS-50 units, if any?

Lost Profits \$298,409.25

Reasonable Royalty \$659,641.50

2. What are Ecolab's damages for Gardner's sales of WS-75 units, if any?

Lost Profits 0

Reasonably Royalty 0

Date: 1/16/03

John F. Furst

Foreperson

399

FILED 1-16-03
RICHARD D. SLETTEN, CLERK
JUDGMENT ENTERED
DEPUTY CLERK JA

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ORIGINAL

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA

ECOLAB INC.,

Plaintiff,

vs.

Civil Action No. 98-2294 (MJD/JGL)

GARDNER MANUFACTURING CO., INC.,

Defendant.

FINAL JUDGMENT

Ecolab Inc. ("Ecolab") and Gardner Manufacturing Co., Inc. ("Gardner") having agreed to the entry of this Final Judgment, the Court hereby finds, orders, adjudges, and decrees that:

Findings of Fact

1. This Court has jurisdiction over the parties to this action and over the subject matter of the pleadings. Venue is also proper in this forum.

2. Ecolab is a Delaware Corporation having its principal place of business at Ecolab Center, St. Paul, Minnesota 55102. Ecolab is engaged in the business of manufacturing, distributing, and selling a wide variety of cleaning and sanitizing products and services including pest elimination products and services to a wide variety of customers including hotels, restaurants, health care facilities, food and beverage processing plants, and others. Ecolab has been a leader in the institutional commercial pest elimination business and a leader in program

FILED JUL 10 2003
RICHARD D. SLETTEN, CLERK
JUDGMENT ENTERED
DEPUTY CLERK

and technological product innovations, such as its Ecolab Flying Insect Defense Program and its Stealth[™] Fly System.

3. Defendant Gardner is a Wisconsin corporation having a principal place of business at 120 West Lake Street, Horicon, Wisconsin 53032. Gardner is engaged, *inter alia*, in the business of selling pest elimination products including flying insect control equipment in interstate commerce.

4. On November 22, 1994, United States Patent No. 5,365,690 (hereinafter "the '690 patent") entitled ADHESIVE LIGHT TRAP was duly and legally issued to Ecolab; and since that date Ecolab has been, and still is, the owner of this patent. A copy of the '690 patent is attached hereto as Exhibit A.

5. On March 3, 1998, Reexamination Certificate B1 5,365,690 was duly and legally issued, confirming the patentability of claims 1-5, 7-10, 13-19, and 21-24. New claims 25-26 were added to the '690 patent. A copy of Reexamination Certificate B1 5,365,690 is attached hereto as Exhibit B. The Reexamination Certificate is hereinafter included in all references to the '690 patent.

6. As found by the jury in this case, Gardner has manufactured, used, imported, offered for sale and/or sold products (the WS-50) that infringe claims the '690 patent and (the WS-75) that could be used in an infringing manner.

7. Any Finding of Fact that is deemed to be a Conclusion of Law is hereby adopted as such.

Conclusions of Law

8. This is an action for patent infringement arising under the patent laws of the United States, 35 U.S.C. § 271 *et seq.* This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338(a).

9. This Court has personal jurisdiction over Ecolab and Gardner, and venue is proper in this district pursuant to 28 U.S.C. § 1400(b).

10. Claims 16, 18 and 26 of the '690 patent are valid and enforceable.

11. This Court explicitly orders, that the issues of infringement are hereby finally concluded and disposed of and that this Final Judgment bars Gardner from contending in this action or any other proceeding that the WS-50 and WS-75 products in suit do not infringe the '690 patent.

12. This Judgment shall finally conclude and dispose of this litigation between Ecolab and Gardner, and they shall be entitled to issue preclusion, claim preclusion, res judicata, and collateral estoppel effect in future litigation or Patent Office proceedings relating to the '690 patent.

13. Any Conclusion of Law that is deemed to be a Finding of Fact is hereby adopted as such.

IT IS HEREBY FOUND, ORDERED, ADJUDGED, AND DECREED that:

A. Gardner, including its officers and directors, agents, servants, employees, attorneys, assignees, and all persons controlling or in active concert or participation with, through, or under Gardner are hereby enjoined from making, using, selling, and/or offering to sell insect light traps identified currently as WS-50. The terms and effect of this injunction shall not

apply to WS-50 units made and sold by Gardner prior to the date of hereof and nothing herein shall preclude Gardner from selling glue boards and light bulbs for use in such WS-50 units.

B. Effective September 1, 2003, Gardner, including its officers and directors, agents, servants, employees, attorneys, assignees, and all persons controlling or in active concert or participation with, through, or under Gardner are also hereby enjoined from making, using, selling, and/or offering to sell insect light traps identified currently as WS-75. The terms and effect of this injunction shall not apply to WS-75 units made and sold by Gardner prior to September 1, 2003 and nothing herein shall preclude Gardner from selling glue boards and light bulbs for use in such WS-75 units.

C. This Judgment shall finally conclude and dispose of all claims and counterclaims between Ecolab and Gardner with prejudice.

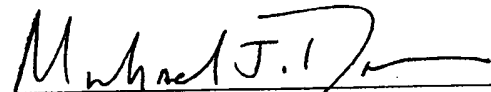
D. The terms of the previous Order, dated April 9, 2003, if any, which are inconsistent with the terms of this Judgment are hereby vacated and the remaining terms are hereby incorporated by reference.

E. Final judgment shall be entered pursuant hereto, forthwith, without further notice.

The Clerk is directed to enter this final judgment forthwith.

IT IS SO ORDERED.

Dated: July 10, 2003




THE HONORABLE MICHAEL J. DAVIS
UNITED STATES DISTRICT COURT JUDGE

HEREBY STIPULATED AND AGREED TO:

ECOLAB INC.,

by its attorneys,

Dated: 6/26/03



Douglas J. Williams, Reg. No. 117,353
Matthew J. Goggin, Reg. No. 210,705
Rachel K. Zimmerman, Reg. No. 314,171
MERCHANT & GOULD P.C.
3200 IDS Center
80 South Eighth Street
Minneapolis, Minnesota 55402-2215
telephone: 612.332.5300

OF COUNSEL:

Andrew Sorensen, Esq.

ECOLAB INC.

Ecolab Center

370 North Wabasha Street

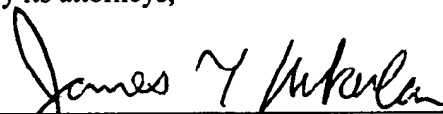
St. Paul, Minnesota 55102

telephone: 612.293.2432

GARDNER MANUFACTURING CO., INC.,

by its attorneys,

Dated: 6/30/03



James T. Nikolai, Reg. No. 144,101
NIKOLAI & MERSEREAU
830 International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402
telephone: 612.339.7461

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

03-1280, -1281

ECOLAB INC.,

Plaintiff-Cross Appellant,

v.

GARDNER MANUFACTURING CO., INC.,

Defendant-Appellant,

and

GUARDIAN PEST CONTROL, INC.,

Defendant.

ORDER

NOTE: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

The parties having so agreed, it is

ORDERED that the proceeding is DISMISSED under Fed. R. App. P. 42 (b).

FOR THE COURT,

Jan Horbaly (Sp)

Jan Horbaly
Clerk

07/03/03

cc: Clerk's Office, DCT
JOAN L. EADS
DOUGLAS J. WILLIAMS

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

JUL - 8 2003

ISSUED AS A MANDATE: 07/03/03

JAN HORBALY
CLERK

ECOLAB V GARDNER MANUFACTURING, 03-1280, -1281
DCT - 98-CV-2294



IN THE UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

ECOLAB INC.,

Plaintiff,

v.

ORKIN EXTERMINATING CO., INC.
and GARDNER MANUFACTURING
CO., INC.,

Defendant.

Civil Action No. 00-CV-2294 MJD/JGL

Judge Michael J. Davis

Magistrate Judge Jonathon G. Lebedoff

STIPULATION OF DISMISSAL WITHOUT PREJUDICE

The parties to this action have resolved their differences through a settlement, the terms of which shall remain confidential. This action is hereby dismissed without prejudice, each party to bear its own attorney fees and costs.

(63)

FILED NOV 17 2003
RICHARD D. SLETTEN, CLERK
JUDGMENT ENTERED
DEPUTY CLERK *[Signature]*

ECOLAB INC.,

by its attorneys,

Dated: 6/27/03

Douglas Williams

Douglas J. Williams, Reg. No. 117,353

MERCHANT & GOULD P.C.

3200 IDS Center

80 South Eighth Street

Minneapolis, Minnesota 55402

(612) 332-5300

OF COUNSEL:

Andrew Sorensen, Esq.

ECOLAB INC.

Ecolab Center

370 North Wabasha Street

St. Paul, Minnesota 55102

(651) 293-2432

ORKIN EXTERMINATING CO., INC.

by its attorneys,

Jon S. Swierzewski

11/5/03

Jon S. Swierzewski, Reg. No. 108,017

LARKIN, HOFFMAN, DALY &

LINDGREN, LTD.

7900 Xerxes Avenue South

1500 Wells Fargo Plaza

Bloomington, MN 55431

telephone: 952.896.3333

Stephen M. Dorvee

ARNALL, GOLDEN &

GREGORY LLP

One Atlantic Center, Suite 2800

1201 West Peachtree Street

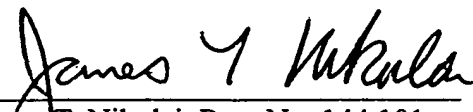
Atlanta, GA 30309-3450

telephone: 404.873.8501

GARDNER MANUFACTURING CO., INC.,

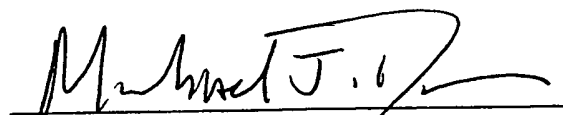
by its attorneys,

Dated: 6/30/03


James T. Nikolai, Reg. No. 144,101
NIKOLAI & MERSEREAU
820 International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402
telephone: 612.339.7461

Joan L. Eads
FOLEY & LARDNER
150 East Gilman Street
Madison, WI 53703
telephone: 608.258.4258

IT IS SO ORDERED.


UNITED STATES DISTRICT COURT
11-14-03

Ecolab, Inc. v. Orkin Exterminating Co., et al., Civil No.: 00-2294 (MJD/JGL)

COPY

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEBRASKA

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| Gary D. McFarland, Clerk | |
| By <i>fw</i> | Deputy |

ECOLAB INC.,

Plaintiff,

v.

PARACLIPSE, INC.,

Defendant.

8:97CV304

VERDICT FORM

1. Has the plaintiff, Ecolab, Inc., proved by a preponderance of the evidence that the Insect Inn IV made by the defendant, Paraclipse, Inc., infringes one or more of the asserted claims of the '690 patent?

____ Yes

☒ No

2. Has the plaintiff, Ecolab, Inc., proved by a preponderance of the evidence that the Insect Inn IV made by the defendant, Paraclipse, Inc., infringes the asserted claim of the '762 design patent?

____ Yes

☒ No

3. If your answer to Question No. 1 or Question No. 2, or both, is yes, what amount of damages do you find, by a preponderance of the evidence, will fairly compensate the plaintiff, Ecolab, Inc., for that infringement? \$ _____

4. If your answer to Question No. 1 or Question No. 2, or both, is yes, has the plaintiff, Ecolab, Inc., proved by clear and convincing evidence that the defendant, Paraclipse, Inc., willfully infringed either or both of the plaintiff's patents?

____ Yes

____ No

Please have your foreperson sign and date this verdict form. You have completed your deliberations.

Date:

Dec. 21, 2000

Charles Lanny Munson
Foreperson

United States Court of Appeals for the Federal Circuit

01-1204, -1205

ECOLAB INC.,

Plaintiff-Appellant,

v.

PARACLIPSE, INC.

(doing business as Paraclipse Automated Insect Control Division),

Defendant-Cross Appellant.

J. Derek Vandenburg, Merchant & Gould P.C., of Minneapolis, Minnesota, argued for plaintiff-appellant. With him on the brief were Douglas J. Williams and Jonelle R. Witt. Of counsel on the brief was Andrew D. Sorensen, Ecolab Inc., of St. Paul, Minnesota.

Keith V. Rockey, Rockey, Milnamow & Katz, Ltd., of Chicago, Illinois, argued for defendant-cross appellant. With him on the brief was Kathleen A. Lyons. Of counsel on the brief was James J. Hill, Emrich & Dithmar, of Chicago, Illinois.

Appealed from: United States District Court for the District of Nebraska

Judge Thomas M. Shanahan

United States Court of Appeals for the Federal Circuit

01-1204, -1205

ECOLAB INC.,

Plaintiff-Appellant,

v.

PARACLIPSE, INC.

(doing business as Paraclipse Automated Insect Control Division),

Defendant-Cross Appellant.

DECIDED: April 3, 2002

Before CLEVENGER, GAJARSA, and DYK, Circuit Judges.

DYK, Circuit Judge.

DECISION

Ecolab Inc. ("Ecolab") brought suit against Paraclipse, Inc. ("Paraclipse") in the United States District Court for the District of Nebraska for infringement of its U.S. Patent No. 5,365,690 ("the '690 patent"). Ecolab appeals the decision of the district court upholding a jury verdict of noninfringement and denying Ecolab's motion for judgment as a matter of law or for a new trial. Ecolab Inc. v. Paraclipse, Inc., No. 8:97CV304 (D. Neb. Dec. 22, 2000). Paraclipse cross-appeals the district court's decision barring Paraclipse from challenging the validity of the '690 patent.

We hold that the district court correctly upheld the jury verdict of noninfringement as to claim 1 of the '690 patent. But because we find that the district court gave an erroneous

and prejudicial jury instruction as to claim 16, we vacate the verdict of noninfringement as to claim 16 and remand for a new trial. We further hold that in the new trial, Paraclipse is entitled to challenge the validity of the '690 patent, because the district court erred in holding that an earlier settlement agreement foreclosed Paraclipse's invalidity defense. We therefore affirm-in-part, reverse-in-part, and remand for a new trial.

I

The '690 patent relates to lighted insect traps used to trap flies in restaurants, hospitals, and other sensitive areas where traditional means of insect control are undesirable. Ecolab sought to develop an insect trap that would be effective in controlling insects in customer-sensitive areas, but that would also be attractive and unobtrusive so customers would not normally recognize the products as insect traps. Recognizing that prior art traps "neither display [insect] attractant light to the maximum advantage nor use an improved trap insect entry geometry," '690 patent, col. 1, ll. 59-61, Ecolab developed the invention recited in the '690 patent known as the Stealth™ trap. The figures of the patent are illustrative of the claimed invention and are reproduced below.

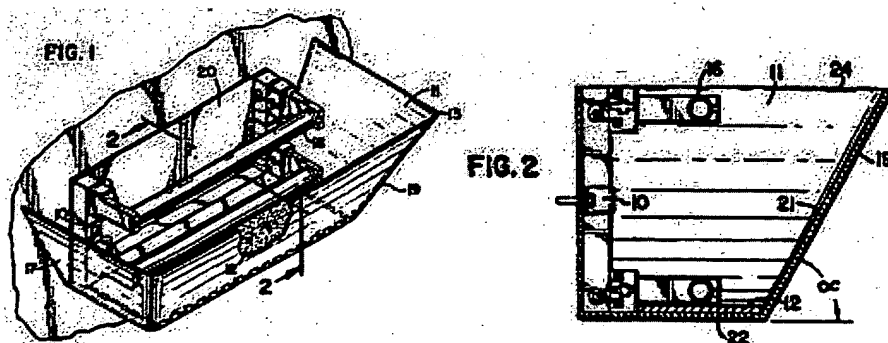


Figure 1 shows a housing having side walls, a bottom wall, and an upwardly facing opening for insect entry. '690 patent, col. 8, ll. 5-19. A light source is positioned within the housing such that the light source cannot be directly viewed when the trap is mounted at or

above eye level. Id., col. 8, ll. 21-28. The trap creates a display of insect attractant light on the vertical wall above the trap on which the trap is mounted. Id., col. 2, ll. 34-40. The invention includes at least one "reflecting surface" that projects reflected light onto the wall to enhance or enlarge the "footprint" of light on the wall surface. Id., col. 8, ll. 34-44. Flying insects are attracted to the footprint of light on the wall above the trap and enter the trap by moving downward through the upwardly-facing opening, where they are immobilized on an adhesive layer contained within the trap. Id.

Independent claims 1 and 16 of the '690 patent are at issue on appeal. Claim 1 recites:

1. A flying insect trap that uses a display of insect attractant light reflected and radiated onto a vertical mounting surface, said trap comprising:
 - (a) a means for mounting a flying insect trap on a vertical mounting surface;
 - (b) a source of insect attractant light; and
 - (c) a housing enclosing the source, said housing comprising:
 - (i) an internal reflecting surface of the housing, positioned with respect to the horizontal such that light from the source of the insect attracting light is directed onto the vertical mounting surface forming a diffused light pattern; and
 - (ii) an insect immobilization surface; wherein the housing comprises an upwardly facing opening for insect entry and the insect attractant light source is placed in the housing below an edge of the upwardly facing opening.

Col. 8, l. 53 - col. 9, l. 2 (emphasis added).

Claim 16 recites:

16. A flying insect trap using reflected and radiated light as an insect attractant, which trap comprises a vertical, planar surface, a housing containing a means to mount the housing on the vertical, planar surface, an insect immobilization surface and a source of insect attractant light wherein the housing is configured such that when mounted on the vertical, planar surface, the source cannot be directly viewed and the housing contains a surface at an angle to the

horizontal, planar surface of less than 80° which reflects light from the source onto the vertical, planar surface, and the trap has an upwardly facing opening.

Col. 10, ll. 9-20 (emphasis added).

Paraclipse manufactures and sells flying insect traps that compete with Ecolab's Stealth™ traps. This is the second time Ecolab has sued Paraclipse for infringement of the '690 patent. Ecolab first sued Paraclipse in 1994, alleging that Paraclipse's Insect Inn II trap infringed the '690 patent. After two years of litigation and just prior to trial, that case was settled by entry of a consent judgment that provided that: "This Court finds and concludes, and Paraclipse agrees, that the '690 patent is a valid patent," that "Paraclipse has infringed the '690 patent by making, using and selling its 'Insect Inn II' product," and that "the invention of the '690 patent is a pioneering invention." Ecolab Inc. v. Paraclipse, Inc., No. 8:94CV601 (D. Neb. Oct. 17, 1996) (order entering consent judgment). The consent judgment required Paraclipse to discontinue sale of the Insect Inn II trap. Id.

Shortly thereafter, Paraclipse introduced the Insect Inn IV trap, the device at issue here. The Insect Inn IV trap has a housing that is closed on the sides and the bottom but open at the top, a UV light bulb within the housing that shines an insect attractant light onto the wall above the trap, and a cartridge having an adhesive surface for trapping flies. The Insect Inn IV trap also includes a shiny black reflector plate immediately below the light bulb, and a Mylar strip located on the vertical back wall of the housing. The insect Inn IV trap differs from the Insect Inn II trap in that (1) it lacks a reflector located between the bulb and the outer wall of the housing, (2) the inside of the outer walls of the housing are black in color, and (3) it has two elements that were not present in the Insect Inn II trap: a shiny

black reflector plate immediately below the light bulb and a Mylar strip on the vertical back wall of the housing. Ecolab sued Paraclipse a second time, alleging that the Insect Inn IV trap infringed the '690 patent, U.S. Patent No. 5,507,017 (the "'017 patent'"), and U.S. Design Patent No. D357,762.¹

The district court held a Markman hearing in November 1998. On August 18, 1999, the district court issued its Markman Order construing the disputed terms "internal reflecting surface"² and "insect attractant light." Ecolab Inc. v. Paraclipse, Inc., No. 8:97CV304 (D. Neb. Aug. 18, 1999) (order on Markman hearing) ("Markman Order"). The district court held that: (1) the term "internal reflecting surface" does not cover a "black matte layer or surface inside the housing;" (2) the term "internal reflecting surface" does not cover a "vertical reflective surface which functions primarily to direct light outward into the room rather than upward on the wall above the trap;" and (3) the "limitation [of dependent claim 25] regarding five foot-candles of reflected light" should not be read into the other claims. Markman Order at 21. The court did not limit the term "internal reflecting surface" to a particular location within the housing.

Before trial, Ecolab filed a motion in limine to preclude Paraclipse from challenging the validity of the '690 patent at trial, arguing that Paraclipse waived the right to assert an

¹ Ecolab withdrew all claims regarding the '017 patent and does not challenge the jury verdict of noninfringement of the design patent. Only the '690 patent is at issue on appeal.

² The term "internal reflecting surface" in claim 1 has the same meaning as the phrase "a surface . . . which reflects light" in claim 16, though, as discussed below, other language in the two claims leads to a different interpretation of the claims. In the discussion below we do not separately discuss the "surface . . . which reflects light" language.

invalidity defense by entering into the consent judgment that provided that: "This Court finds and concludes, and Paraclipse agrees, that the '690 patent is a valid patent." Ecolab Inc. v. Paraclipse, Inc., No. 8:94CV601 (D. Neb. Oct. 17, 1996) (order entering consent judgment). The district court granted the motion, and barred Paraclipse from introducing evidence challenging the validity of the '690 patent. Ecolab, No. 8:97CV304 (D. Neb. Dec. 7, 2000) (order granting motion in limine). The district court also barred Paraclipse from defending on the ground that it was practicing the prior art of expired U.S. Patent No. 4,876,822 ("the White patent"). Id.

The case was tried to a jury in December 2000. With respect to claim interpretation, the district court gave the jury Instruction No. 11:

The terms "interior reflective surface" and "internal reflecting surface," used in the claims of the '690 patent, do not include a black matte surface inside the housing, that is, a black matte on the inner wall of the housing. "Direct light," as described in the patents, means light radiated directly from the source of the light onto the wall above the unit. The term "reflected light," as used in the patent claims, means the light from the source which bounces off, i.e., is reflected off, a reflecting surface on the inside wall of the housing cover.

An internal reflecting surface which is "positioned with respect to the horizontal such that light from the source of the insect attractant light is directed onto the vertical mounting surface" does not include vertical surfaces on the rear wall of the housing which are positioned to reflect light out into a room. Even if some "incidental" illumination of the wall results from a reflective surface on the rear wall of the housing, the claims do not include a vertical reflective surface which functions primarily to direct light outward into the room, rather than upward onto the wall above the trap.

(emphasis added). The jury returned a verdict of noninfringement as to both claims.

Ecolab filed a motion pursuant to Fed. R. Civ. P. 50(b) and 59(a) seeking judgment of infringement as a matter of law, or a new trial. The district court denied the motion.

Ecolab Inc. v. Paraclipse, Inc., No. 8:97CV304 (D. Neb. Jan. 19, 2001). Ecolab timely filed this appeal. We have jurisdiction under 28 U.S.C. § 1295(a)(1) (1994).³

II

We review the denial of a motion for judgment as a matter of law without deference. Dawn Equip. Co. v. Ky. Farms Inc., 140 F.3d 1009, 1014, 46 USPQ2d 1109, 1111 (Fed. Cir. 1998). We review the denial of a motion for a new trial for abuse of discretion. Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 854, 20 USPQ2d 1252, 1254-55 (Fed. Cir. 1991), cert. denied, 504 U.S. 980 (1992).

Claim construction is an issue of law, Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71, 34 USPQ2d 1321, 1322 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996), that we review without deference, Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (en banc). A determination of infringement is a question of fact. Bai v. L & L Wings, Inc., 160 F.3d 1350, 1353, 48 USPQ2d 1674, 1676 (Fed. Cir. 1998).

III

Ecolab argues it is entitled to a new trial because the district court erroneously instructed the jury regarding claim interpretation. Specifically, Ecolab complains that Instruction No. 11 is erroneous because (1) it excluded the black matte surface and the

³ Paraclipse's pending motion for attorney's fees does not prevent us from exercising jurisdiction. The mere fact that the attorney's fee issue has not been resolved does not render the district court's judgment as to infringement nonfinal. See Budinich v. Becton Dickinson & Co., 486 U.S. 196, 199-203 (1988) (holding that a judgment on the merits is final and appealable despite a pending motion for attorney's fees).

vertical reflecting surface behind the bulb as qualifying “internal reflecting surface[s],” and (2) it required the “reflecting surface” to be located “on the inside wall of the housing cover.”

I. “Internal reflecting surface”

Ecolab asserts that the district court erred by instructing the jury that neither a “black matte surface” nor a vertical reflecting surface behind the bulb qualifies as an “internal reflecting surface.” We first address whether Ecolab’s failure to object to this portion of Instruction No. 11 at the jury instruction conference constituted a waiver or whether raising the issue at the Markman hearing was sufficient.

Ecolab fully briefed its position concerning the proper construction of “internal reflecting surface” in the claims at the Markman hearing. The district court rejected that interpretation as a matter of law in its Markman Order. Ecolab argues that it would have been futile to raise this argument a second time by objecting to the jury instruction incorporating the disputed claim construction, and equally futile to prepare and submit jury instructions in conflict with that Markman Order.

The requirements of Federal Rule of Civil Procedure 51 are governed by regional circuit law, in this case, the law of the Eighth Circuit. Embrex, Inc. v. Serv. Eng’g Corp., 216 F.3d 1343, 1350, 55 USPQ2d 1161, 1165 (Fed. Cir. 2000). The question of whether there should be a “futility” exception to Rule 51 has been much discussed. In this particular area, the Eighth Circuit’s view may diverge from that of other circuits.

Rule 51 generally requires a party to object to an error in a jury instruction before the jury retires in order to preserve the claim of error on appeal, Fed. R. Civ. P. 51;⁴ City of

⁴ Federal Rule of Civil Procedure 51 states in pertinent part:

Springfield v. Kibbe, 480 U.S. 257, 258-60 (1987), thereby giving the district court the opportunity to recognize and correct any error it may have made in the instruction before charging the jury. But a general rule has evolved that “[a] litigant is excused from complying with the strict objection requirement of Rule 51 if the district court is aware of the party’s position and it is plain that further objection would be futile,” where “[the] litigant’s position [was] ‘clearly made’ to the district court.” 9 James Wm. Moore et al., Moore’s Federal Practice, § 51.12[2][a], at 51-40.2 to 51-41 (3d ed. 1997); accord 9A C. Wright & A. Miller, Federal Practice and Procedure, § 2553, at 441 (2d ed. 1986) (“The failure to object may be disregarded if the party’s position has been made clear to the trial judge and it is plain that a further objection would be unavailing.”). This is known as the “futility” exception.

For example, in Dresser Industries, Inc. v. Gradall Co., 965 F.2d 1442, 1450 (7th Cir. 1992), a party in a contract dispute did not object to a jury instruction defining a contract term but was nonetheless allowed to challenge the instruction on appeal, because the party had fully briefed the argument on summary judgment and the district court had rejected the same argument in denying summary judgment. Id. A further objection would have been “futile.” Id. Similarly, in Hamman v. Southwestern Gas Pipeline, Inc., 821 F.2d 299, 303, vacated in part on other grounds on reh’g, 832 F.2d 55 (5th Cir. 1987), the Fifth Circuit held that a party had not waived its challenge to a jury instruction, where the party’s position on the same legal issue had been clearly stated in the party’s trial brief, and had

No party may assign as error the giving or the failure to give an instruction unless that party objects thereto before the jury retires to consider its verdict, stating distinctly the matter objected to and the grounds of the objection.

Fed. R. Civ. P. 51.

been rejected by the district court. Again, the court of appeals found that further objection would have been futile.

According to Moore's Federal Practice, "[f]ederal courts of appeal in all jurisdictions recognize this [futility] exception." 9 James Wm. Moore et al., Moore's Federal Practice, § 51.12[2][a], at 51-41 (3d ed. 1997). This, however, may not be true in the Eighth Circuit. In Starks v. Rent-A-Center, 58 F.3d 358, 362 (8th Cir. 1995), the court did not excuse a party's failure to object to a jury instruction, even though the trial judge repeatedly indicated that he preferred that counsel not repeat arguments already presented, because "[i]n this circuit, . . . concern that the trial judge would prefer no objection or the view that the objection would be futile does not relieve the parties from making an objection to preserve errors for review." See also Jones Truck Lines, Inc. v. Full Serv. Leasing Corp., 83 F.3d 253, 256 (8th Cir. 1996) (citing and quoting Starks, 58 F.3d at 362). Starks is factually distinguishable from this case. In Starks, the court of appeals reviewed the record at length to demonstrate that the trial judge was open to reconsidering his earlier ruling. Starks, 58 F.3d at 362. We are nonetheless uncomfortable concluding that the Eighth Circuit would allow a futility exception in this case. However, we need not finally dispose of the futility issue since we conclude that even if the objections were properly preserved, there was no error in this portion of Instruction No. 11.

To determine whether there was error in this portion of the jury instruction, we examine the district court's construction of the claim term "internal reflecting surface" as excluding both a "black matte surface" and a vertical surface behind the bulb.

1. Black matte surface

The section of Instruction No. 11 excluding a black matte surface from the scope of the term “internal reflecting surface”⁵ was based on the district court’s Markman ruling that “a black matte layer or surface inside the housing does not constitute a [sic] ‘interior reflective surface’ or an ‘internal reflecting surface’ within the meaning of the Ecolab patent claims.” Markman Order at 21.

Ecolab argues that any surface of any color positioned inside the housing to reflect any degree of light onto the wall qualifies as an “internal reflecting surface.” But Table 5 of the ’690 patent makes it clear that not every black surface is an “internal reflecting surface.” Table 5 outlines the results of an experiment “compar[ing] the effect of the installation of the shiny metallized polyester (Mylar) reflective surface within the housing with the effect of a non-reflecting surface.” ’690 patent, col. 7, ll. 48-64. The “non-reflecting surface” used in the experiment was black. Ecolab has not distinguished the black matte surface from the non-reflecting surface of Table 5. Moreover, if “a surface that does reflect light from the source, even if only a small amount,” is “reflective” within the meaning of claims 1 and 16, then no surfaces would be excluded and the term “reflective” would be meaningless. The district court concluded, and we agree, that because the term “internal reflecting surface” requires a surface having at least some small amount of reflectivity, the black matte surface on the inner wall of the housing cover (which is only minimally reflective) does not qualify. Markman Order at 11. We therefore find that the section of Instruction No. 11 excluding the black matte surface as an “internal reflecting surface” was not erroneous.

⁵

The district court instructed the jury that:

2. Vertical surface located behind the light source

The section of Instruction No. 11 excluding the "vertical surface[]" on the rear wall of the housing . . . positioned to reflect light out into a room"⁶ was based on the district court's Markman ruling that:

the Ecolab patent claims do not include a vertical reflective surface which functions primarily to direct light outward into the room rather than upward onto the wall above the trap, and this is so even if some incidental illumination of the wall occurs.

Markman Order at 21. The district court read the plain language of the claims as requiring the "internal reflecting surface" to function primarily to reflect light upward onto the wall above the trap. Id. at 14. The district court based its interpretation on the prosecution history, where Ecolab distinguished the prior art on the ground that "[t]he prior art traps are optimized to direct light away from the trap into the room environment. The Stealth™ brand trap of the claimed invention [in contrast] forms a light pattern, attractive to flying insects, on a vertical surface or wall above the trap." Id. at 15. The district court reasoned, and we agree, that "one of ordinary skill in the art would understand that an internal reflecting

The terms "interior reflective surface" and "internal reflecting surface," used in the claims of the '690 patent, do not include a black matte surface inside the housing, that is, a black matte on the inner wall of the housing.

⁶ The district court instructed the jury in Instruction No. 11 that:

An internal reflecting surface which is "positioned with respect to the horizontal such that light from the source of the insect attractant light is directed onto the vertical mounting surface" does not include vertical surfaces on the rear wall of the housing which are positioned to reflect light out into a room. Even if some "incidental" illumination of the wall results from a reflective surface on the rear wall of the housing, the claims do not include a vertical reflective surface which functions primarily to direct light outward into the room, rather than upward onto the wall above the trap.

surface which is 'positioned with respect to the horizontal such that light from the source of insect attractant light is directed onto the vertical mounting surface' does not include vertical surfaces on the rear wall of housing which are positioned to reflect light out into the room." Id. The district court determined that the "vertical surface[] on the rear wall of the housing . . . positioned to reflect light out into a room" (i.e., the "Mylar strip") of the Insect Inn IV trap reflects light outward into the room and away from the wall, rather than upward onto the wall as required by the claims. Id. at 15. Accordingly, the district court ruled that the Mylar strip cannot qualify as an "internal reflecting surface." We agree, and find that the section of Instruction No. 11 incorporating this claim construction was not erroneous.

B. Located on the inside wall of the housing cover

Ecolab next challenges the section of Instruction No. 11 stating that "[t]he term 'reflected light' . . . means the light from the source which bounces off, i.e., is reflected off, a reflecting surface on the inside wall of the housing cover:"

"Direct light," as described in the patents, means light radiated directly from the source of the light onto the wall above the unit. The term "reflected light," as used in the patent claims, means the light from the source which bounces off, i.e. is reflected off, a reflecting surface on the inside wall of the housing cover.

Ecolab argues that this instruction improperly limited the scope of claims 1 and 16 of the patent to include only reflecting surfaces that are "located on the inside wall of the housing cover."

Unlike the claim construction issues discussed above, this issue was not addressed or decided at the pre-trial Markman hearing. Accordingly, whatever the vitality of the "futility" exception in the Eighth Circuit, Ecolab is bound by the strict requirements of Rule 51 and must have properly raised an objection to the district court in order to preserve the

issue on appeal. Paraclipse urges that Ecolab failed to object to this section of Instruction No. 11 and propose alternative instructions, but Paraclipse is wrong. Ecolab properly objected after the court submitted its proposed jury instructions to the parties,⁷ and proposed the following alternative language: “a reflecting surface in the trap, inside the trap’ . . . [or] [i]nstead of saying in the trap, let’s just use the exact language from the claim, ‘a reflecting surface of the housing.’”

An erroneous instruction regarding claim interpretation that affects the jury’s decision on infringement is grounds for a new trial. A party seeking to alter a judgment based on erroneous jury instructions must establish that “those instructions were legally erroneous,” and that “the errors had prejudicial effect.” Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1281, 54 USPQ2d 1673, 1679 (Fed. Cir. 2000). Whether a jury instruction is legally erroneous is a question of law. Brooktree Corp. v. Advanced Micro Devices, Inc., 977 F.2d 1555, 1570, 24 USPQ2d 1401, 1411 (Fed. Cir. 1992).

Because the pertinent language of claims 1 and 16 is different, we consider the correctness of Instruction No. 11 separately with respect to the two claims.⁸

⁷ Ecolab pointed out that “this is the language, Your Honor, that we spoke about at the beginning of trial where they interpret it saying that the reflecting surface must only be on the inside wall of the housing cover. And that is the exact language of the court’s Markman ruling, but as we pointed out, . . . if you read your Markman ruling . . . literally, that it had to be on the cover, then all the rest of Your Honor’s language about what was and wasn’t qualifying surfaces would be superfluous.”

⁸ Ecolab argues that “[i]t is improper to construe claims in such a way that they do not cover the admittedly infringing product from an earlier lawsuit between the same two parties,” (citing San Huan New Materials High Tech, Inc. v. Int’l Trade Comm’n, 161 F.3d 1347, 1357-58, 48 USPQ2d 1865, 1873-74 (Fed. Cir. 1998), cert. denied, 528 U.S. 959 (1999)) and that the Insect Inn II and IV traps are indistinguishable in this respect. There is no such rule, and San Huan does not support this proposition. Instead, San Huan was

1. Claim 1

The jury instruction is correct as to claim 1. Ecolab argues that nothing in claim 1 limits the "internal reflecting surface" to a particular location "on the inside wall of the housing cover." We disagree. Claim 1 specifically requires that the "internal reflecting surface" be part "of the housing." '690 patent, col. 8, l. 62.

While the claim language is not as clear as it might be, we think that the term "housing" refers to the exterior walls, the cover, and the bottom wall, but not the elements contained "within" the housing. Ecolab argues that the term "housing" can encompass "elements beyond the external walls . . . shown in the preferred embodiment," because "claim 1 explicitly states that the housing also includes the insect immobilization surface, which is a separate element placed on top of the bottom wall." We disagree. The immobilization surface is not clearly a "separate element," because the specification states that the "adhesive surface rests upon a bottom portion . . . which is a part of the housing." '690 patent, col. 8, ll. 24-26. This claim language does not persuade us that the term "housing" should be construed to encompass all elements contained within the housing. Rather, the term "housing" refers to the exterior walls, the cover, and the bottom wall.

Ecolab also argues, to no avail, that the specification does not limit the reflecting surface to a particular location, relying on the following language:

The reflection surface can be the exterior wall of the trap or can be a surface installed within a vertical wall or a wall mounted at an angle other than the angle of the reflected surface.

precluded from arguing for a claim construction because that claim construction was inconsistent with the construction it had already agreed to in a consent decree.

'690 patent, col. 5, ll. 48-51 (emphasis added). This language might be read to suggest that the reflecting surface may be separate from the housing cover in some embodiment of the invention. We nonetheless look first to the particular claim language to ascertain what that claim requires. See Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999) ("The starting point for any claim construction must be the claims themselves."). The specification does not suggest that we should construe claim 1 more broadly than its language suggests.

2. Claim 16

The jury instruction is erroneous as to claim 16. Claim 16 requires only that the "housing contain[] a surface . . . which reflects light." '690 patent, col. 10, ll. 16-18 (emphasis added). The ordinary meaning of "contain" is "to have within." Webster's Third New Int'l Dict., 490-491 (1966). Thus, claim 16 does not require the reflecting surface to be located "on the inside wall of the housing cover."

However, to warrant a new trial, Ecolab must show that the erroneous jury instruction was in fact prejudicial. When the error in a jury instruction "could not have changed the result, the erroneous instruction is harmless." Environ Prods., Inc. v. Furon Co., 215 F.3d 1261, 1266-67, 55 USPQ2d 1038, 1043 (Fed. Cir. 2000) (citing 11 Charles Alan Wright & Arthur R. Miller, Federal Practice and Procedure § 2886, at 467-70 (2d ed. 1995) ("Errors in instructions are routinely ignored if . . . the error could not have changed the result.")); Weinar v. Rollform Inc., 744 F.2d 797, 808, 223 USPQ 369, 376 (Fed. Cir. 1984) ("[A] reversal . . . is not available to an appellant who merely establishes error in instructions Where the procedural error was 'harmless,' i.e., where the evidence in support of the verdict was so overwhelming that the same verdict would necessarily be reached absent

the error, or the error was cured by an instruction, a new trial would be mere waste and affirmance of the judgment is required.”), cert. denied, 470 U.S. 1084 (1985).

This requires us to examine whether there was sufficient evidence at trial to support a finding of infringement under a correct instruction. We must therefore determine whether Ecolab presented sufficient evidence to support a finding that the Insect Inn IV trap “contains” at least one “surface . . . which reflects light” as required by claim 16. Ecolab argues that six surfaces qualify: (1) the shiny black plate located directly beneath the light source; (2) the portion of the white paper supporting the adhesive layer that is not hidden by the reflecting plate; (3) the Mylar strip behind the light source; (4) the support posts for the bulb; (5) the outer surface of the light bulb; and (6) the black matte inner wall of the housing cover. To determine whether any of these surfaces might qualify as a “surface . . . which reflects light” we consider the limitations of claim 16.

a. “One bounce”

We conclude that claim 16 includes a “one bounce” limitation, requiring the “surface . . . which reflects light” to reflect light directly onto the wall, rather than reflecting light onto another surface that reflects light onto the wall. Ecolab argues that “[n]othing in [the claim] language requires that light travel directly from the reflecting surface to the wall.” But claim 16 explicitly requires “a surface . . . which reflects light from the source onto the vertical, planar surface” ’690 patent, col. 10, ll. 17-19 (emphasis added). This suggests a requirement that the light bounce directly from the reflecting surface onto the wall above the trap. Moreover, the natural interpretation of the phrase “surface . . . which reflects” requires that light travel directly from the reflecting surface to the wall, and does not encompass a

situation where the reflecting surface reflects light to another surface (such as the outer surface of the bulb), and then up onto the wall.

The district court similarly noted that “the term ‘reflected light’ as used in the patent claims means the light from the source which bounces off . . . the reflecting layer on the inside wall of the housing cover.” (emphasis added). Markman Order at 11. The district court correctly included this interpretation in the jury instruction:

The term “reflected light,” as used in the patent claims, means the light from the source which bounces off, i.e. is reflected off, a reflecting surface on the inside wall of the housing cover.

We believe that a jury could find that two surfaces meet this limitation: the shiny black plate located directly beneath the light source,⁹ and the portion of the white paper supporting the adhesive layer that is not hidden by the reflecting plate. We need not address whether other surfaces, i.e. the Mylar strip, the support posts for the bulb, and the bulb itself, also meet this limitation.

b. Threshold amount of light

Paraclipse urges that the instruction was not prejudicial because the claims require “at least five foot-candles of reflected light.” Paraclipse contends that during reexamination, Ecolab tried to distinguish the White prior art as lacking a “reflected light intensity that is greater than the threshold for fly attraction,” and that this requirement was not shown to be satisfied. The district court rejected this argument, finding that “the Examiner did not consider the five foot-candle limitation to be a part of the invention, and

⁹ This shiny black reflector plate is clearly distinguishable from the non-reflective black matte surface discussed above on pages 11-12.

so, the original claims must not now be 're-written' to incorporate the limitation in claim 25 regarding five foot-candles of reflected light on the wall." Markman Order at 20. We hold that the district court correctly concluded that "only claim 25, added during the reexamination proceedings, is limited to a threshold of five foot-candles of reflected light." Id. at 21.

c. Ultraviolet light

Paraclipse also argues that the instruction was not prejudicial because claim 16 requires reflected ultraviolet ("UV") light, and that there was no showing that UV light was reflected. But Claim 16 does not require ultraviolet light. Only dependent claim 17 specifies "insect attractant light" as "ultraviolet." Claim 17 recites "[t]he trap of claim 16 wherein the insect attractant light comprises a source of ultraviolet light." '690 patent, Col. 10, ll. 21-22. Under the doctrine of claim differentiation, "each claim in a patent is presumptively different in scope." Intermatic Inc. v. Lamson & Sessions Co., 273 F.3d 1355, 1364, 61 USPQ2d 1075, 1081-82 (Fed. Cir. 2001). This presumption is especially strong where "there is a dispute over whether a limitation found in a dependent claim should be read into an independent claim, and that limitation is the only meaningful difference between the two claims." Id. (quoting Wenger Mfg., Inc. v. Coating Mach. Sys., Inc., 239 F.3d 1225, 1233, 57 USPQ2d 1679, 1685 (Fed. Cir. 2001)). Because the only meaningful difference between claims 16 and 17 is the limitation of ultraviolet light, under the doctrine of claim differentiation, claim 16 does not require ultraviolet light.

Because we find sufficient evidence to support a jury verdict of infringement under the correct interpretation of claim 16, we conclude that Ecolab suffered prejudice by the

erroneous jury instruction. We therefore vacate the verdict of noninfringement as to claim 16, and remand for a new trial.

We also hold that the district court correctly denied Ecolab's motion for judgment as a matter of law on its patent infringement claim. Ecolab argues that it is entitled to judgment as a matter of law if we adopt Ecolab's proffered claim construction. Because we do not adopt Ecolab's proffered claim construction, there is no basis for us to grant judgment as a matter of law.

IV

We next address Paraclipse's cross-appeal regarding the district court's decision barring Paraclipse from challenging the validity of the '690 patent. We find that the district court erred in precluding Paraclipse from asserting an invalidity defense, and hold that Paraclipse shall be allowed to challenge the validity of the '690 patent in the new trial.

We interpret consent judgments in accordance with the general principles of contract law, Diversey Lever, Inc. v. Ecolab, Inc., 191 F.3d 1350, 1352, 52 USPQ2d 1062, 1064 (Fed. Cir. 1999), such that "the scope of a consent decree is limited to its terms and . . . its meaning should not be strained." Foster v. Hallco Mfg. Co., 947 F.2d 469, 481, 20 USPQ2d 1241, 1250 (Fed. Cir. 1991). Moreover, "provisions in a consent judgment asserted to preclude litigation of the issue of validity in connection with a new claim must be construed narrowly." Id.; Diversey Lever, 191 F.3d at 1352, 52 USPQ2d at 1252 ("Any surrender of the right to challenge validity of a patent is construed narrowly."). Thus, a party does not waive its right to challenge the validity of a patent as to future accused products absent a clear intent to do so. To determine whether to give the consent judgment in this case preclusive effect, we therefore turn to the language of the agreement itself.

In Foster, we found that the alleged infringer was not precluded from challenging the validity of the patent where the consent decree merely stated that the patents were “valid and enforceable in all respects.” Foster, 947 F.2d at 481, 20 USPQ2d at 1250. We found that that language standing alone was insufficient to bar the alleged infringer from challenging validity. In that situation, a future validity challenge would have been precluded only if the devices in the two suits were “essentially the same,” that is, if the accused product in the second suit was “essentially the same” as the specific device that was before the court in the first suit. Foster, 947 F.2d at 479-480, 20 USPQ2d at 1249.

In Diversey Lever, we found that the language standing alone in the agreement at issue was sufficient to bar the alleged infringer from challenging validity, where the alleged infringer, in addition to agreeing that the patents were “valid and enforceable,” further agreed that it would not “directly or indirectly aid, assign, or participate in any action contesting the validity” of the patents. Diversey Lever, 191 F.3d at 1352, 52 USPQ2d at 1064. We noted that Foster requires more for a waiver of the invalidity defense as to future accused products,” id., and found the “something more” in this additional language.

Here, the consent judgment is more analogous to the agreement in Foster than Diversey Lever. Paraclipse merely agreed in the consent judgment that “the ‘690 patent is a valid patent.” Greater clarity than this is required to foreclose a validity defense in a new infringement suit involving a new product. Because the language of the consent judgment does not, standing alone, preclude the validity challenge, we must determine whether the products are “essentially the same.” The record shows that the Insect Inn IV trap differs from the Insect Inn II trap in that (1) it lacks a reflector located between the bulb and the outer wall of the housing, (2) the inside of the outer walls of the housing are black in color,

and (3) it has two elements that were not present in the Insect Inn II trap: a shiny black reflector plate immediately below the light bulb and a Mylar strip on the vertical back wall of the housing. Thus, the record demonstrates to our satisfaction that the Insect Inn II and IV devices are not “essentially the same.”

Relying on Foster, Ecolab argues that even if the language of the decree standing alone is insufficient to preclude an invalidity defense, it is entitled to introduce extrinsic evidence as to the parties' intent. Without determining under what circumstances a district court may look beyond the language of the agreement to extrinsic evidence of intent, we find that in this case, the extrinsic evidence offered by Ecolab did not raise a genuine issue of material fact as to whether the agreement should be interpreted to preclude the invalidity defense. Ecolab argues that it presented “powerful” extrinsic evidence showing that Paraclipse understood the consent judgment to have preclusive effect, but points only to Paraclipse's belated assertion of its invalidity defense as its extrinsic evidence. This is hardly sufficient.

Finally, Paraclipse argues that the district court improperly barred it from showing that the Insect Inn IV trap cannot infringe because its Insect Inn IV trap more closely resembles the expired White prior art patent than the '690 patent. Specifically, Paraclipse argues that “[e]ach one of those same surfaces of the Insect Inn IV relied on by Ecolab as constituting the claimed ‘reflective’ surface is likewise found in the White prior art unit.” But “practicing the prior art” is not a defense to literal infringement. Baxter Healthcare Corp. v. Spectramed, Inc., 49 F.3d 1575, 1583, 34 USPQ2d 1120, 1126 (Fed. Cir. 1995), cert. denied, 516 U.S. 906 (1995); see also Tate Access Floors, Inc. v. Interface Architectural Res., Inc., 279 F.3d 1357, 1365, 61 USPQ2d 1647, 1653 (Fed. Cir. 2002). Instead,

"[q]uestions of obviousness in light of the prior art go to validity of the claims, not whether an accused device infringes." Baxter, 49 F.3d at 1583; 34 USPQ2d at 1126. Thus, Paraclipse cannot properly assert as a noninfringement defense that "[i]f the claims read on Insect Inn IV, they must also read on the prior art."

In sum, the district court erred in precluding Paraclipse from challenging the validity of the '690 patent with respect to Paraclipse's new product, the Insect Inn IV trap.

CONCLUSION

We find that the district court correctly interpreted the claims and gave a correct jury instruction as to claim 1, but incorrectly interpreted the claims, in part, and gave an erroneous jury instruction as to claim 16. We accordingly affirm the verdict of noninfringement as to claim 1, and vacate the verdict of noninfringement as to claim 16, and remand for a new trial. We further hold that at the new trial, Paraclipse shall be allowed to challenge the validity of the '690 patent.

Therefore, we affirm-in-part, reverse-in-part, and remand for new trial as to claim 16.

AFFIRMED-IN-PART, REVERSED-IN-PART, and REMANDED.

COSTS

No costs.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEBRASKA

FILED
U.S. DISTRICT COURT
DISTRICT OF NEBRASKA

03 DEC 17 PM 3:02

ECOLAB INC.,

Plaintiff,

vs.

PARACLIPSE, INC., d/b/a Paraclipse
Automated Insect Control Division,

Defendant.

GARY D. McFARLAND
CLERK
8:97CV304

MEMORANDUM AND ORDER

This matter is before the court on Filing No. 298, the "Plaintiff Ecolab's Motion to Exclude All References to or Evidence of the Pending Reexamination of the Patent at Issue, or in the Alternative, to Stay the Case Pending the Outcome of the Reexamination Proceeding and Request for *Expedited* Review." For the reasons stated herein, the court denies Ecolab's motion to exclude all references to or evidence of the pending reexamination of the patent at issue, and the court grants Ecolab's motion to stay the case pending the outcome of the reexamination hearing.

Following the first trial, both parties appealed to the United States Court of Appeals for the Federal Circuit. Ultimately, the Federal Circuit remanded the case for a new trial. The Federal Circuit held that in the second trial, the Defendant, Paraclipse, Inc. ("Paraclipse"), should "be allowed to challenge the validity of [Ecolab's] '690 patent" Ecolab Inc. v. Paraclipse, Inc., 285 F.3d 1362, 1367 (Fed. Cir. 2002). Accordingly, a principal issue for the trial currently set for February 2, 2004 is whether Ecolab's '690 patent is valid.

After the Federal Circuit remanded this case, Paraclipse filed a request for reexamination of the validity of Ecolab's '690 patent with the United States Patent and

Trademark Office. On August 26, 2003, the United States Patent and Trademark Office granted Paraclipse's request for reexamination of Ecolab's '690 patent. (Filing No. 317, Ex. K.) The United States Patent and Trademark Office determined that "a substantial new question of patentability . . . is raised by the request for reexamination." (Filing No. 317, Ex. K.)

Ecolab states that it "anticipates that Paraclipse will try to use the fact that a reexamination of the '690 patent is pending to improperly influence the jury into believing there is a problem with the validity of the '690 patent." (Filing No. 299 at 3.) Therefore, Ecolab has filed this motion, requesting that for the upcoming trial the court enter an order precluding Paraclipse from raising the pending reexamination. Ecolab argues that the fact that the United States Patent and Trademark Office granted a request for reexamination has no bearing on the question of validity of Ecolab's patent in this lawsuit. Accordingly, Ecolab contends the admission of evidence of the reexamination would be in direct contravention of Federal Rule of Evidence 402, which prohibits the admission of irrelevant evidence. Ecolab also maintains that the probative value of the reexamination evidence is substantially outweighed by the unfair prejudice and, therefore, should be excluded pursuant to Federal Rule of Evidence 403.

"The standard for what constitutes relevant evidence is a low one: evidence is relevant if it has 'any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence.'" United States v. Tinoco, 304 F.3d 1088, 1120 (11th Cir. 2002) (quoting Fed. R. Evid. 401)). See also United States v. Powers, 59 F.3d 1460, 1465 (4th Cir. 1995) ("The threshold for relevancy is relatively low"); Iacobucci v. Boulter, 193 F.3d 14, 20 (1st

Cir. 1999) ("Relevancy is a fluid concept under the Evidence Rules. . . . Consequently, relevancy typically presents a rather low barrier to admissibility"). With the low barrier presented by relevancy for the admissibility of the subject evidence (reexamination of '690 patent), the court concludes that evidence that the United States Patent and Trademark Office granted Paraclipse's request for reexamination of Ecolab's '690 patent may have some bearing, however small, on whether Ecolab's patent is valid.

The more difficult question is whether the probative value of the reexamination is substantially outweighed by the unfair prejudicial effect. Ecolab argues that the introduction of the reexamination evidence would mislead the jury: "If a jury were to hear evidence concerning the Patent Office's grant of a request for reexamination, the jury's ability to appreciate the presumption of validity of an issued patent would be significantly impaired." (Filing No. 299 at 5.) The court recognizes Ecolab's concern. Nevertheless, "there is a strong presumption that relevant evidence should be admitted, and thus for exclusion under Rule 403 to be justified, the probative value of evidence must be 'substantially outweighed' by the problems in admitting it." Coleman v. Home Depot, Inc., 306 F.3d 1333, 1343-44 (3rd Cir. 2002).

In ruling on a Rule 403 motion, the court must "necessarily . . . engage in balancing to determine whether the probative value of the evidence is 'substantially outweighed' by the negative factors listed in Rule 403." Coleman at 1344. "Rule 403 recognizes that a cost/benefit analysis must be employed to determine whether or not to admit evidence." Coleman at 1343. However, in employing a balancing test, this court recognizes that such a 403 objection may prove to be dependent on trial context. See United States v. Mejia-Alarcon, 995 F.2d 982, 986- 88 (10th Cir.1993); see also Fusco v. General Motors

Corp., 11 F.3d 259, 263 (1st Cir. 1993) ("Needless to say, most district judges are very cautious about making a definitive ruling in limine that evidence will not be received at trial. Trial judges know better than most that many issues are best resolved in context and only when finally necessary"). Trial is "the better time to evaluate the possible exclusion of testimony because it is at that time that the claims of prejudice and irrelevance move out of the abstract context of a motion in limine into the real world" Rojas v. Richardson, 703 F.2d 186, 188 (5th Cir. 1983). "Deferring admissibility decisions until trial is the better practice because 'there are countervailing considerations, especially with respect to ... rulings under Rule 403 which [if] made pre-trial [would be] without the benefit of the flavor of the record developed at trial.'" Clark v. Tennessee Valley Elec. Co-op., 2002 WL 1397270, *2 (W.D. Tenn. April 2, 2002) (unpublished) (quoting In re Japanese Elec. Prods. Antitrust Litig., 723 F.2d 238, 260 (3rd Cir.1983), rev'd sub nom. on other grounds, Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574 (1986)).

In this case, the court feels that Ecolab's motion for exclusion and the interest of overall fairness requires disposition of the motion in the evidential context of the trial in this matter. Accordingly, the court denies Ecolab's motion to exclude evidence of the reexamination. In ordinary circumstances, the court would deny such a motion without prejudice to a party reasserting the motion at trial. However, such a ruling may be unnecessary in this case insofar as the court next decides whether a stay of the case pending reexamination of Ecolab's patent is the appropriate course in this case.

In the alternative to Ecolab's motion to exclude all references to or evidence of the pending reexamination of the patent at issue, Ecolab requests a stay of the proceedings pending the outcome of the reexamination hearing. In response, Paraclipse states that it

"does not wish to spend any more money than it has to and would agree to a stay of the trial pending the resolution of the reexamination proceeding." (Filing No. 305 at 3.) Moreover, Paraclipse argues that a stay pending the outcome of the reexamination proceeding would minimize the prejudice to either party and would conserve the resources of the parties and the court. (Filing No. 309 at 17.)

Authority exists for the court to stay this case. See, e.g., Ethicon, Inc. v. Quigg 849 F.2d 1422, 1426-27 (Fed. Cir. 1988) ("Courts have inherent power to manage their dockets and stay proceedings including the authority to order a stay pending conclusion of a PTO reexamination"). In Gould v. Control Laser Corp., 705 F.2d 1340 (Fed. Cir. 1983), the plaintiff appealed the United State District Court for the Middle District of Florida's stay of proceedings until conclusion of reexamination of a patent by the Patent and Trademark Office. The Federal Circuit held that this course was proper and in fact recognized the district court's prudence in issuing a stay. The Federal Circuit stated: "One purpose of the reexamination procedure is to eliminate trial of that issue (when the claim is canceled) or to facilitate trial of that issue by providing the district court with the expert view of the PTO (when a claim survives the reexamination proceeding)." Gould at 1342. Accordingly, staying the case pending the outcome of reexamination would aid the court in the trial of this case.

An additional reason to stay the case is that such a stay will likely not be lengthy. As the court in Bausch & Lomb Inc. v. Alcon Laboratories, Inc., 914 F.Supp. 951 (W.D.N.Y. 1996) explained: "Because the reexamination is to be conducted 'with special dispatch' (35 U.S.C. § 305), [the court] find[s] that a short stay of the proceedings before [this court]

will not greatly prejudice any party and will serve to promote judicial economy." Bausch & Lomb Inc. at 953.

Ecolab has moved for stay; Paraclipse does not oppose the motion; the court recognizes the prudence of staying the case. Accordingly, the court grants Ecolab's motion to stay the case until the United States Patent and Trademark Office has issued a final decision on the reexamination of Ecolab's '690 patent. The court directs the parties to inform the magistrate judge assigned to this case when the United States Patent and Trademark Office completes its reexamination of Ecolab's '690 patent; at that time, the court will issue a new progression order and reschedule the case for trial.

THEREFORE, IT IS ORDERED:

- (1) That Ecolab's motion to exclude all references to or evidence of the pending reexamination of the patent at issue (Filing No. 298) is denied;
- (2) That Ecolab's motion to stay this case pending the outcome of the United States Patent and Trademark Office's reexamination proceeding is granted (Filing No. 298); and
- (3) That this case is stayed until the completion of the United States Patent and Trademark Office's reexamination proceeding at which time the court will reschedule this case for trial.

DATED this 17th day of December, 2003.

BY THE COURT:


THOMAS M. SHANAHAN
United States District Judge



90/006659



PTO/US/57 (04-01)

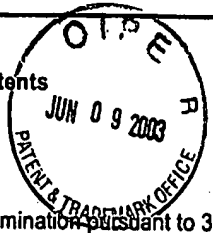
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(Also referred to as FORM PTO - 1465)

REQUEST FOR EX PARTE REEXAMINATION TRANSMITTAL FORM

Address to:
Assistant Commissioner for Patents
Box Reexam
Washington, D.C. 20231



Attorney Docket No. Para. 6
Date: 06/05/2003

1. ☒ This is a request for *ex parte* reexamination pursuant to 37 CFR 1.510 of patent number 5,365,690 issued 11/22/1994. The request is made by:

☐ patent owner. ☒ third party requester.

2. ☒ The name and address of the person requesting reexamination is:

Paraclipse, Inc.
P.O. Box 686
Columbus, NE 68602-0686

3. ☒ a. A check in the amount of \$ 2,520.00 is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(i);

☐ b. The Commissioner is hereby authorized to charge the fee as set forth in 37 CFR 1.20(c)(i) to Deposit Account No. _____; or

☐ c. Payment by credit card. Form PTO-2038 is attached.

4. ☒ Any refund should be made by ☐ check or ☒ credit to Deposit Account No. 05-1060 37 CFR 1.26(c). If payment is made by credit card, refund must be to credit card account.

5. ☒ A copy of the patent to be reexamined having a double column format on one side of a separate paper is enclosed. 37 CFR 1.510(b)(4)

6. ☐ CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table

7. ☐ Nucleotide and/or Amino Acid Sequence Submission
If applicable, all of the following are necessary

a. ☐ Computer Readable Form (CRF)

b. Specification Sequence Listing on:

i ☐ CD-ROM (2 copies) or CD-R (2 copies); or

ii ☐ paper

c. ☐ Statements verifying identity of above copies

8. ☒ A copy of any disclaimer, certificate of correction or reexamination certificate issued in the patent is included.

9. ☒ Reexamination of claim(s) 16 and 18 is requested.

10. ☒ A copy of every patent or printed publication relied upon is submitted herewith including a listing thereof on Form PTO-1449.

11. ☐ An English language translation of all necessary and pertinent non-English language patents and printed publications is included.

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12. ☒ The attached detailed request includes at least the following items:
- a. A statement identifying each substantial new question of patentability based on prior patents and printed publications. 37 CFR 1.510(b)(1)
 - b. An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited art to every claim for which reexamination is requested. 37 CFR 1.510(b)(2)

13. ☐ A proposed amendment is included (only where the patent owner is the requester). 37 CFR 1.510(e)

14. ☒ a. It is certified that a copy of this request (if filed by other than the patent owner) has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c).

The name and address of the party served and the date of service are:

Ronald A. Daignault and Mark DiPietro of Mechant, Gould, Smith, Edell, Welter & Schmidt
1000 Norwest Center
St. Paul, MN 55101-2701

Date of Service: 06/05/2003; or

- ☐ b. A duplicate copy is enclosed since service on patent owner was not possible.

15. ☐ Correspondence Address: Direct all communication about the reexamination to:

☐ Customer Number

OR

Type Customer Number here

Place Customer Number Bar
Code Label here

| | | | | | |
|---|-----------------------------------|-------|--------------|-----|-------|
| <input checked="" type="checkbox"/> Firm or Individual Name | James J. Hill | | | | |
| Address (line 1) | Emrich & Dithmar | | | | |
| Address (line 2) | 300 South Wacker Drive, Ste. 3000 | | | | |
| City | Chicago | State | IL | Zip | 60606 |
| Country | U.S.A. | | | | |
| Telephone | 312/663-9800 | Fax | 312/663-9822 | | |

16. ☒ The patent is currently the subject of the following concurrent proceeding(s):

- ☐ a. Copending reissue Application No. _____
- ☐ b. Copending reexamination Control No. _____
- ☐ c. Copending Interference No. _____
- ☒ d. Copending litigation styled:

SEE ATTACHED

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James J. Hill
 Authorized Signature

06/05/2003

Date

☐ For Patent Owner Requester

☒ For Third Party Requester

THE UNIVERSITY OF CHICAGO

Ecolab, Inc. v. Anderson Environment, et al. - C.A. No. 0:03CV1160 (D. Minn.)



FEE TRANSMITTAL for FY 2003

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 2,520.00

Complete if Known

Application Number

Filing Date

First Named Inventor

Examiner Name

Art Unit

Attorney Docket No.

PARA. REEX

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number
Deposit Account Name

05-1060

Emrich and Dithmar

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description | Fee Paid |
|----------------------------|----------------------------|------------------------|----------|
| 1001 750 | 2001 375 | Utility filing fee | |
| 1002 330 | 2002 165 | Design filing fee | |
| 1003 520 | 2003 260 | Plant filing fee | |
| 1004 750 | 2004 375 | Reissue filing fee | |
| 1005 160 | 2005 80 | Provisional filing fee | |
| SUBTOTAL (1) (\$) | | | |

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|---------------------------|--------------|----------------|----------|
| Independent Claims | -20** = | X | |
| Multiple Dependent Claims | -3** = | X | |

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description |
|----------------------------|----------------------------|--|
| 1202 18 | 2202 9 | Claims in excess of 20 |
| 1201 84 | 2201 42 | Independent claims in excess of 3 |
| 1203 280 | 2203 140 | Multiple dependent claim, if not paid |
| 1204 84 | 2204 42 | ** Reissue independent claims over original patent |
| 1205 18 | 2205 9 | ** Reissue claims in excess of 20 and over original patent |
| SUBTOTAL (2) (\$) | | |

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description | Fee Paid |
|----------------------------|----------------------------|--|----------|
| 1051 130 | 2051 65 | Surcharge - late filing fee or oath | |
| 1052 50 | 2052 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 130 | 1053 130 | Non-English specification | |
| 1812 2,520 | 1812 2,520 | For filing a request for <i>ex parte</i> reexamination | 2,520 |
| 1804 920* | 1804 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 1,840* | 1805 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 110 | 2251 55 | Extension for reply within first month | |
| 1252 410 | 2252 205 | Extension for reply within second month | |
| 1253 930 | 2253 465 | Extension for reply within third month | |
| 1254 1,450 | 2254 725 | Extension for reply within fourth month | |
| 1255 1,970 | 2255 985 | Extension for reply within fifth month | |
| 1401 320 | 2401 160 | Notice of Appeal | |
| 1402 320 | 2402 160 | Filing a brief in support of an appeal | |
| 1403 280 | 2403 140 | Request for oral hearing | |
| 1451 1,510 | 1451 1,510 | Petition to institute a public use proceeding | |
| 1452 110 | 2452 55 | Petition to revive - unavoidable | |
| 1453 1,300 | 2453 650 | Petition to revive - unintentional | |
| 1501 1,300 | 2501 650 | Utility issue fee (or reissue) | |
| 1502 470 | 2502 235 | Design issue fee | |
| 1503 630 | 2503 315 | Plant issue fee | |
| 1480 130 | 1480 130 | Petitions to the Commissioner | |
| 1807 50 | 1807 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 180 | 1806 180 | Submission of Information Disclosure Stmt | |
| 8021 40 | 8021 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 750 | 2809 375 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 750 | 2810 375 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 750 | 2801 375 | Request for Continued Examination (RCE) | |
| 1802 900 | 1802 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 2520.00

SUBMITTED BY

Name (Print/Type)

James J. Hill

Registration No.

24287

(Complete if applicable)

Telephone 312/663-9800

Signature

James J. Hill

Date

06/05/2003

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This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REQUEST FOR *EX PARTE* REEXAMINATION
UNDER 37 C.F.R. §1.510

Patent Requested to be Reexamined: U.S. Patent 5,365,690

Date of Issue: November 22, 1994

Inventors: Nelson, et al.

**Title: FLYING INSECT TRAP USING REFLECTED AND
RADIATED LIGHT**

**Assignee: Ecolab, Inc.
St. Paul, MN**

Attorney for Requester and Correspondence Address:

James J. Hill, Esq.
Reg. No. 24,278
EMRICH & DITHMAR
Suite 3000
300 South Wacker Drive
Chicago, IL 60606
Telephone 312/663-9800
Facsimile 312/663-9822

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. 5,365,690)
Inventors: Nelson, et al.)
Issue Date: November 22, 1994)
Title: FLYING INSECT TRAP)
USING REFLECTED AND)
RADIATED LIGHT)
Requester: Paraclipse, Inc.)

REQUEST FOR EX PARTE REEXAMINATION
UNDER 37 C.F.R. §1.510

The Honorable Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

Paraclipse, Inc. of Columbus, Nebraska, hereby requests *Ex Parte* Reexamination under 35 U.S.C. §302 and 37 C.F.R. §1.510 of United States Patent No. 5,365,690, issued November 22, 1994 for FLYING INSECT TRAP USING REFLECTED AND RADIATED LIGHT, Thomas D. Nelson and Douglas G. Anderson, inventors (hereinafter the "Nelson patent").

**STATEMENT OF SUBSTANTIAL NEW QUESTIONS OF
PATENTABILITY**

The following substantial new questions of patentability are raised
in this request:

1. Claims 16 and 18 are anticipated under 35 U.S.C. §102(b)
by U.S. Patent 4,876,822 for FLYING INSECT CONTROL
UNIT USING LIGHT AND ADHESIVES, (White), issued
October 31, 1989.
2. Claims 16 and 18, considered in their entireties, do not
define nonobvious subject matter under 35 U.S.C. §103(a)
in view of the teachings of White U.S. Patent 4,876,822,
identified above, and U.S. Patent 3,059,373, for INSECT
KILLING LAMP (Gardner) issued October 23, 1962.

Copies of the White and Gardner patents are enclosed.

Preliminary Remarks

Before setting forth a detailed explanation of the pertinency of the
prior art, it will be helpful to note two principles - one legal and one
technical - concerning this Request.

First, Title 35 has been amended effective November, 2002 to
override the decision of the Court of Appeal For the Federal Circuit in *In
re Portola Packaging, Inc.*, 110 F.3d 786,44 USPQ2d 1060 (1997).

The Amendment of Section 303(a) (effective November 2, 2002)

now provides:

The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

As discussed in further detail below, in a 1995 Reexamination of the Nelson Patent, the Examiner was forced to withdraw a Final Rejection of Claims 16 and 18 (among others) while the case was under appeal due to a decision of the Court of Appeals for the Federal Circuit -- *In re Portola Packaging, Inc.*, 122 F3d 1373, 44 USPQ2d 1060 (Fed. Cir. 1997). Congress has now enacted legislation which overrides the *Portola Packaging* decision. The current Reexamination thus provides the PTO with an opportunity to correct the earlier injustice.

Second, reflection of light includes both spectral reflection (in which the reflecting surface is idealized such that incident light is not scattered and the angles of incidence and reflection are equal), and diffuse reflection which occurs in the real world such that light scatters and is reflected in all directions upon incidence.

It is important to keep this principle of optics in mind because in prior prosecution of the application leading not the '690 patent, the patent

one thing to obtain its patent, and turned around and is now attempting to read claim 16 on a structure identical to the White prior art.

The patent owner has been able to accomplish this by ignoring the physics of diffuse light reflection. The physics of diffuse versus specular light reflection follow well-known laws of physics and are accepted principles. Requester has included scientific definitions and examples of tutorials to explain the two types of reflection in attachments A, B, C and D.

In the McGraw-Hill Dictionary of Scientific and Technical Terms (Daniel N. Lapedes), Copyright 1969 (Attachment A), the term "diffuse reflection" (p. 410) is defined as:

Reflection of light, sound or radio waves from a surface in all directions according to the cosine law.

Of particular interest, the diagram in the margin of page 410 (dating to 1953) shows an incident light ray from the left producing reflected light in all directions upwardly. The description beneath the diagram states that the reflection pattern is produced "from a mat surface of microscopic roughness". The intensity of the reflected light may vary with the angle of reflection, but claim 16 is silent on intensity.

At page 1392, the term, "specular reflection" is defined as:

Reflection of electromagnetic, acoustic, or water waves in which the reflected waves travel in a definite direction, and the directions of the incident and reflected waves make equal angles with a line perpendicular to the reflecting surface, and lie in the same plane with it. Also known as direct reflection; mirror reflection; regular reflection.

Adjacent the definition at p. 1392 is the classic diagram for specular reflection, in which the reflection is commonly described as "the angle of incidence equals the angle of reflection" relative to the surface of incidence.

Also enclosed is a portion of the textbook "OPTICS" 2nd Edition, Eugene Hecht (1987, 1974), Chapter 4 (Attachment B). Reference is made to page 88 illustrating the difference between specular reflection on the left and diffuse reflection on the right.

Attachment C is a textbook "Physics For Technology", Betts (1981), Chapter 28. Note page 474 of Chapter 28, Figure 28-1 and accompanying description. Attachment D is a printout of a portion of a website explaining specular and diffuse reflection. The Examiner may wish to visit the site at:

<http://micro.magnet.fsu.edu/primer/java/scienceopticsu/reflection/specular/>

The website is interactive, and color adds to enhance understanding.

It is important to note that Requester is citing accepted principles of physics -- not as prior art, but as general knowledge within the skill of the art (even at the high school physics level). The principles are well-known to those in the art of lighting devices. Requester's purpose in citing these materials is to alert the Examiner so that the patent owner cannot, as was previously done, provide legal argument which ignores the physical laws.

The Court of Appeals for the Federal Circuit has recently approved and encouraged the use of technical treatises and dictionaries for construing the language of claims in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 64 USPQ 2d 1812 (Fed. Cir. 2002) In that case, the Court stated,

It has been long recognized in our precedent and in the precedent of our predecessor court, the Court of Customs and Patent Appeals, that dictionaries, encyclopedias and treatises are particularly useful resources to assist the Court in determining the ordinary and customary meaning of claim terms. (Citations and similar quotes omitted.) *Id.*, 308 F.3d at 1202, 64 USPQ 2d at 1818.

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**DETAILED EXPLANATION OF PERTINENCY AND MANNER OF
APPLYING THE CITED PRIOR ART TO CLAIMS 16 AND 18**

Reading of Claim 16 onto the Disclosure of White

Claim 16 of Nelson Patent

White Patent 4,876,822

16. A flying insect trap using reflected and radiated light as an insect attractant, which trap comprises

White discloses a flying insect trap capable of illuminating an area while attracting insects with light (Col. 1, lines 6-9).

a vertical, planar surface,

Vertical wall 48 (FIG. 3; Col. 4, line 4).

a housing containing

Elongated side walls 26 (i.e. front and rear) and end walls 28 and planar bottom wall 16 form an enclosure or housing 18. (FIG. 3; Col. 3 lines 9-12).

a means to mount the housing on the vertical, planar surface,

Fasteners 46 (FIGS. 1-3; Col. 3, lines 60-61).

an insect immobilization surface and

"Once the insects are lured into the [unit] they are trapped by a sticky layer or coating 20 (FIG. 3) provided on an outer exposed reflective layer 22 of a strip member 24". (Col. 3, lines 4-8).

ENCLOSURE 060490

a source of insect attractant light

wherein the housing is configured such that when mounted on the vertical, planar surface, the source cannot be directly viewed and

the housing contains a surface at an angle to the horizontal, planar surface of less than 80° which reflects light from the source onto the vertical, planar surface, and

the trap has an upwardly facing opening.

“...ultraviolet light source 12 for emitting insect-attracting light rays ... for the purpose of luring insects into the enclosure 18.” (Col. 2, line 67 - Col. 3, line 1).

The side walls 26 and end walls 28 and the forward portion bottom wall 16 are solid walls forming an enclosure 18. (FIG. 3, Col. 3, lines 9-12).

Horizontal or reflective surface 22 of strip member 24 (Col. 3, lines 6-7). See also Col. 3, line 15 disclosing the “reflective insect-trapping strip 24”.

Col. 3, beginning at line 45 discloses that the arrangement of elements causes other light rays to be reflected off the outer reflective surface 22 of the strip 24 and out the upper opening 40 of the enclosure 18 (lines 47-49). See also, FIG. 3.

It is thus submitted that every limitation of claim 16 is found in the disclosure of the Nelson patent and claim 16 is therefore anticipated by the White prior art patent.

SECRET - EYES ONLY

Sticky layer or coating 20 (FIG. 3) provides an outer exposed reflective surface 22 of strip member 24 for "trapping" insects. (Col. 3, lines 4-12).

Once reexamination is ordered, the Examiner may reject any claim of the patent in issue. The White reference applies equally effectively to many of the claims in the '690 patent, but is particularly effective with respect to claims 1 and 26 thereof.

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**Detailed Explanation of the Manner in Which Claims 16 and 18 Do
Not Define Nonobvious Subject Matter Under Section 103(a).**

The Patent Owner is expected to argue that the White patent has a passageway 14 in the bottom wall 16 through which the light source can be seen, and thus the White reference does not meet the limitation that "the source cannot be directly viewed". Obviously, the light source of Nelson can be viewed directly from above the unit. Claim 16 is silent as to where or how high the unit is mounted or where the viewer must be for the claimed result, and this will be discussed further below. For present purposes, even if the quoted limitation were found not to be met by the White prior art, claim 16 and 18 are invalid under Section 103(a) for the reasons set out above combined with the teachings of Gardner U.S. Patent 3,059,373.

Gardner discloses an insect trap which provides the motivation, if there be any doubt, for shielding the light source from view. Specifically, Gardner discloses a container or housing 17 which is mounted on a base 13 for receiving a light bulb 39. As Gardner discloses, beginning in Col. 2, line 70 "container 17 is preferably opaque and imperforate and extends upwardly from base 13 to an upper open end."

Gardner's motivation for his improvement is set out in Col. 1, beginning on line 36 where it is disclosed that prior art devices (the application was filed in 1961 -- over 40 years ago) were unsightly,

claims 16 and 18 FIVE separate times. First, the Order granting the Request for Reexamination in control No. 90/003,779, paper no. 5, dated June 6, 1995 predicated the grant of the request on the basis that claims 1, 3-5, 7-8, 10, 16, 18 and 19 are "fully anticipated by the prior art" -- namely the White patent.

In an Office Action in the 1995 Reexamination, mailed April 26, 1996, paper no. 8, claims 16 and 18, among other claims were rejected as anticipated by White under 35 U.S.C. §102(b). (See Office Action, p. 5, para. 9). Claims 16 and 18 were rejected a third time, in paper no. 17, an Office Action dated November 29, 1996 (see p. 2, para. 3, of Office Action).

Subsequently, in paper no. 22, dated February 28, 1997, the rejection of claims 16 and 18, among others, was confirmed. Finally, in paper no. 29, April 7, 1997, the same rejection was confirmed for a fifth time.

Following an appeal by Ecolab, the first reexamination was terminated when the rejection of the claims was withdrawn in view of *In re Portola Packaging, Inc.*, 122 F.3d 1373, 44 USPQ2d 1060 (Fed. Cir. 1997). See, Notice of Intent to issue reexamination certificate, paper no. 32, dated July 9, 1997.

The rejection of claims 16 and 18 in the 1995 Reexamination was never overturned and was withdrawn only because of the *Portola*

Packaging decision. That unfortunate decision has now been overridden by Congress, as noted above. The five rejections clearly and beyond any reasonable argument establish that Requester has presented a substantial new question of patentability, in this proceeding. In addition, the above application of claim 16 word-for-word onto the disclosure of White establishes a substantial question of patentability which has never been decided by the PTO. Finally, the above combination of White and Gardner presents a new issue of patentability never before raised in the PTO.

The Standard of Review and Reexamination

Foremost in this proceeding is the principle that the claims of an issued patent during Reexamination do not enjoy the statutory presumption of validity. *In re Etter*, 756 F.2d 852, 857, 225 USPQ 14 (Fed. Cir. 1985).

The Court of Appeals for the Federal Circuit stated in *In re Yamamoto*, 740 F.2d, 1569, 1571, 224 USPQ 934, 936 (Fed. Cir. 1984) observed that the standard for interpreting claims during PTO examination is that the claims are to be given their "broadest, reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims". This rule is based on the reasoning that during examination in the PTO, the patent owner

has an opportunity to amend the claims to define his/her contribution relative to the prior art. This is unlike the situation in a Federal District Court action where the Court has no authority to rewrite the claims. Moreover, see M.P.E.P. Section 2257, p. 2200-69 (subpart. g). See also, *Burlington Industries, Inc. v. Quigg*, 822 F.21581-1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987) in which the Court held that patent application claims are given their broadest reasonable interpretation because before prosecution is ended, claims are readily amended as part of the examination process.

It is clear from the above principles of light reflection that light emanating from the lamp 12 in Fig. 3 of White is incident upon the reflective surface 22 and is diffusely reflected, radiating in all directions upwardly, including vertically as well as directly on the wall 48 above the unit -- precisely the principle on which the patent owner has predicated the patentability of the claims of the '690 patent. The patent owner's arguments have previously ignored the fundamental principle of diffuse reflection of light. Notably, the claims do not define the amount of light, but only refer to "reflected" light. Nor do the claims distinguish between diffusely reflected or spectrally reflected light.

The prior art White patent explicitly teaches:

- (a) That surface 22 of adhesive strip 24 is reflective, Col. 3, line 6, and

(b) That the disclosed arrangement of light source and reflecting surface causes "light rays to be reflected off the outer reflective surface 22 of the strip 24 and out of the open upper end 40 of the enclosure 18." (Col. 3, lines 46-50).

Requester's Comments on Arguments Ecolab is Expected to Make

Ecolab (the patent owner) is expected to make one or more of the following arguments.

A. That the White prior art is primarily intended to emit light out the passageway 14 in the bottom 16 as seen in Fig. 3.

This argument ignores the fact that the language of claim 16 reads word-for-word on the teachings and structure of White. The issue presented in claim 16 is reflected light, not direct light; and in White, the reflecting surface 22 faces upwardly toward the top opening, not the bottom one.

A second, independent reason for rejecting any such argument by the Patent Owner is that the language of claim 26 of the Nelson patent that the "housing surrounds the source such that substantially all fly attracting light exits the trap through the upwardly facing opening" could have been added to claim 16, had the Patent Owner intended the claim to be so limited. However, even then such a limitation would not render claim 16 patentable in light of the explicit teaching of White that an open

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top is an independent source of reflected and direct light, and the only means of providing a light pattern above the wall-mounted unit.

Finally, if the patent owner wants to limit claim 16 to a closed bottom, it is capable of defining such a limitation. See for example, claim 26 of the 1995 Reexamination certificate which recites, in Col. 2, beginning line 25 that the housing "comprises an upwardly facing opening for insect entry and the insect attractant light source is placed in the housing ... and wherein the housing surrounds the source such that substantially all fly attracting light exits the trap through the upwardly facing opening."

B. Ecolab is expected to argue that the reflective adhesive strip 24 of White is not a "surface... which reflects light from the source".

As the Court of Appeals for the Federal Circuit noted in *Ecolab, Inc. v. Paraclipse, Inc.* 285 F.3d 1362; 62 USPQ2d 1349, (2002) (p. marked 9 of copy attached), page 1374 of the Fed. 3d report, Ecolab argued at trial and upon appeal that the "portion of the white paper supporting the adhesive layer that is not hidden by the reflecting plate" of the accused Paraclipse device was just such a surface. Ecolab should not be permitted to argue out of both sides of its mouth. The adhesive trapping surface of the accused Paraclipse structure is just such a surface -- identical in form and function to that disclosed in the White patent.

C. Another argument Ecolab is likely to make is that Requester

has entered into an earlier consent decree with Ecolab.

The Federal Circuit held in the Appellate decision that the trial court had made an error in precluding Paraclipse from contesting the validity of the Nelson patent because the consent Decree was limited to an earlier device, 285 F.3d at 1377, 62 USPQ 2d at 1359-1360. (Attachment E, page marked 10). Therefore, any consent decree was not binding with respect to the issues of the contested litigation and no weight should be afforded the prior consent decree. It was a private contract between two parties. No evidentiary hearing was held, and it relates only to an earlier, discontinued version of the device which was introduced prior to issuance of the '690 patent. Lawsuits are settled for many reasons, and in this case, it was settled primarily to avoid the cost of litigation.

Of overriding weight on this issue is the Patent Office's own rejection, in the first reexamination proceeding cited above, of claim 16 on five separate occasions as being anticipated by the White prior art.

D. Another argument the Patent Owner is expected to make, discussed briefly above, is that claim 16 recites that the source "cannot be viewed directly" when the unit is mounted, and that this is true for the patented structure, whereas the White device has a lamp which can be viewed directly beneath the unit.

Claim 16 is vague and indefinite as it does not recite from what view or elevation it is that the source "cannot be viewed directly", nor where the viewer is located in a room.

In keeping with the above-cited decisions of the Federal Circuit, the claims during examination are to be given their broadest, reasonable interpretation consistent with the specification; and limitations appearing in the specification are not to be read into the claims. In this case, there is no limitation in the specification which can be read into claim 16 which would make the quoted language clear and definite. This indefiniteness should be held against the Patent Owner because it is the Patent Owner's lack of definition and disclosure which results in the indefiniteness.

The claim should be interpreted such that the device is viewed from a distance in a room in which it is mounted. The reason is that the entire insect attractant pattern is recited throughout the prosecution of the application of the Nelson patent to be up on the wall above the unit. Since that pattern of light cannot be viewed by an observer directly beneath the unit when mounted on the wall, such a position has no meaning since the nature of the claimed subject matter is that of a dual purpose lamp, one to be mounted in an eating area, for example.

E. Another argument that the Patent Owner may make is that claim 18 has been held valid by a decision resulting from District Court litigation in Minnesota. This argument (which does not apply to claim 16) is rebutted directly by §2241 of the Manual of Patent Examination Procedure, page 2200-45 (August 2001) beneath the caption "Policy Where a Federal Court Decision has Been Issued on the Patent". In subsection (A), it is specifically stated

...[T]he existence of a final court decision of *claim validity* in view of the same or different prior art does not necessarily mean that no new question is present, because of the different standards of proof employed by the Federal District Courts and the Office.

While the Office may accord deference to factual findings made by the District Court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, because it is not controlling on the Office.

Conclusion

In conclusion, it is beyond dispute that claim 16 is invalid as anticipated by the cited White patent. Throughout the first reexamination, the patent owner argued that the White unit did not reflect "light" out the top of the unit. The laws of physics require that light which is diffusely reflected off the horizontal white adhesive strip 24 of the White patent produces reflected light which is incident upon the wall above the

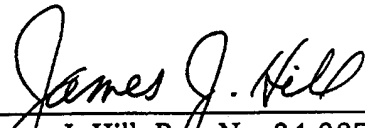
unit. The source of the White patent obviously, from Figs. 1 and 3, emanates light directly onto the wall above the unit.

Moreover, claim 16 is invalid under §103(a) in that, to the extent the Examiner finds any limitation in claim 16 not expressly recited in the White reference, the Gardner patent discloses a housing with only an upwardly extending opening, the specific purpose of which is to hide the light source from view.

Claim 18 provides no basis for patentability. The White prior art clearly discloses an adhesive surface for trapping insects alighting upon it.

Respectfully submitted,

Date: June 5, 2003


James J. Hill, Reg. No. 24,287
EMRICH & DITHMAR
Suite 3000
300 South Wacker Drive
Chicago, Illinois 60606
(312) 663-9800

Certificate of Mailing under 37 CFR 1.8

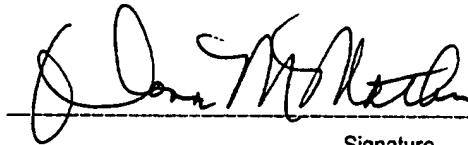
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Date



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Donna M. Mathis

Typed or printed name of person of signing Certificate

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Transmittal Form for Request for Reexamination;
 Request for Reexamination (consisting of 21 pages; 4 patents, Exhibits A-E)
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 90/006,659 | 06/09/2003 | 5365690 | Para. 6 | 9653 |

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MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/26/2003

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Resp 2 Oct 26, 2003

Resp 3 Feb 24, 2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|---------------|----------------------------|--|
| Order Granting / Denying Request For Ex Parte Reexamination | Control No. | Patent Under Reexamination | |
| | 90/006,659 | 5365690 | |
| | Examiner | Art Unit | |
| | Darren W. Ark | 3643 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 09 June 2003 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☒ PTO-892, b) ☐ PTO-1449, c) ☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**


For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) ☐ by Treasury check or,
b) ☐ by credit to Deposit Account No. _____, or
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).


Darren W. Ark
Primary Examiner
Art Unit: 3643

cc: Requester (if third party requester)

| | | | |
|-----------------------------------|---------------------------------------|---|-------------|
| Notice of References Cited | Application/Control No. 90/006,659 | Applicant(s)/Patent Under Reexamination 5365690 | |
| | Examiner Darren W. Ark | Art Unit 3643 | Page 1 of 1 |

U.S. PATENT DOCUMENTS

| * | | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Name | Classification |
|---|---|--|-----------------|--------------------------|-------------------|
| * | A | US-5,385,690 | 11-1994 | Nelson et al. | 43/113 |
| * | B | US-4,876,822 | 10-1989 | White, James N. | 43/113 |
| * | C | US-3,059,373 | 10-1962 | Gardner | 43/113 |
| | D | US- | | | |
| | E | US- | | | |
| | F | US- | | | |
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| | M | US- | | | |

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| * | | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Country | Name | Classification |
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NON-PATENT DOCUMENTS

| * | | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|---|
| | U | |
| | V | |
| | W | |
| | X | |

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

DETAILED ACTION

Reexamination

1. A substantial new question of patentability affecting claims 1-24 of United States Patent Number 5,365,690 is raised by the request for reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in reexamination proceedings are provided for in 37 CFR 1.550(c).

The consideration of U.S. Patent Number 4,876,822 to White raises a substantial new question of patentability as to claims 1-24 of the Nelson et al. patent. As pointed out on pages 8-10 of the request, White discloses a vertical planar surface (vertical wall 48), a housing (elongated side walls 26 and end walls 28 and bottom wall 16 form a housing 18), means to mount the housing on the vertical surface (fasteners 46), an insect immobilization surface comprises an adhesive surface (sticky layer or coating 20 on strip member 24), a source of insect attractant light (light source 12), wherein the housing being configured such that when mounted on the vertical, planar surface, the source cannot be directly viewed (the side walls 26 and end walls 28 and the forward portion bottom wall are solid walls forming an enclosure 18), and the housing contains a surface at an angle to the horizontal, planar surface of less than 80 degrees which reflects light from the source onto the vertical, planar surface (horizontal surface 22 of

member 24), and the trap has an upwardly facing opening (the arrangement of elements causes other light rays to be reflected off the outer reflective surface 22 of strip 24 and out the upper opening 40 of the enclosure 18). Further, there is a substantial likelihood that a reasonable examiner would consider this important in deciding whether or not the claims are patentable. Accordingly, U.S. Patent Number 4,876,822 to White raises a substantial new question of patentability as to Claims 1-24, which question has not been decided in a previous examination of the Nelson et al. patent.

The consideration of U.S. Patent Number 3,059,373 to Gardner raises a substantial new question of patentability as to claims 1-24 of the Nelson et al. patent. As pointed out on page 11 of the request, the Gardner reference discloses the housing (housing 17 [preferably opaque and imperforate] mounted on a base 13 for receiving bulb 39) which is configured such that when mounted on the vertical, planar surface, the source cannot be directly viewed. Further, there is a substantial likelihood that a reasonable examiner would consider this important in deciding whether or not the claims are patentable. Accordingly, U.S. Patent Number 3,059,373 to Gardner raises a substantial new question of patentability as to Claims 1-24, which question has not been decided in a previous examination of the Nelson et al. patent.

2. The above substantial new question of patentability is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

"The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art", does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists a SNQ based solely on the White patent. A discussion of the specifics now follows:

The White patent is being presented/viewed in a new light, or different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. The White patent was not previously interpreted so as to "throw a pattern of reflected light on the wall" from

horizontal reflective surface (22) since the trap of White was interpreted as only having "spectral reflection" where incident light is not scattered and the angles of incidence and reflection are equal, but the new argument or interpretation that the horizontal reflective surface (22) does indeed "throw a pattern of reflected light on the wall" is made due to the nature and physics of "diffuse reflection" which is defined as "Reflection of light...waves from a surface in all directions according to the cosine law" in the McGraw-Hill Dictionary of Scientific and Technical Terms 1969. Therefore, a SNQ is raised with regard to the White patent in view of the material new argument or interpretation presented in the request.


3. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,365,690 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Art Unit: 3643

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Darren W. Ark
Primary Examiner
Art Unit 3643

DWA
August 21, 2003

Merchant & Gould

An Intellectual Property Law Firm

3200 IDS Center
80 South Eighth Street
Minneapolis, Minnesota
55402-2215 USA
TEL 612.332.5300
FAX 612.332.9081
www.merchant-gould.com

A Professional Corporation

Direct Contact

Rachel K. Zimmerman
612.336.4667
rzimmerman@merchant-gould.com

July 7, 2003

Via Hand Delivery

Clerk of Court
U.S. District Courthouse
300 South Fourth Street
Suite 202
Minneapolis, MN 55415

Re: Ecolab Inc. v. Anderson Environmental Systems, Inc. et al.
Civil Action No. 03-1160 DSD/SRN
M&G 4163.1USZA

Dear Sir/Madam:

I enclose an original and two copies of the following document for filing in the above-referenced case:

Notice of Voluntary Dismissal Without Prejudice Pursuant to Fed.R.Civ.P.
41(a)(1).

Please contact me with any questions or concerns related to this filing.

Very truly yours,



Rachel K. Zimmerman

RKZ:ae

Enclosures

Minneapolis/St. Paul
Denver
Seattle
Atlanta
Washington, DC

IN THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF MINNESOTA

| | | |
|--------------------------------------|---|-----------------------------|
| Ecolab Inc., |) | |
| |) | |
| |) | Civil No. 03-1160 (DSD/SRN) |
| Plaintiff, |) | |
| |) | |
| v. |) | |
| |) | |
| Anderson Environmental Systems, Inc. |) | |
| and Andex Company |) | |
| |) | |
| Defendants. |) | |

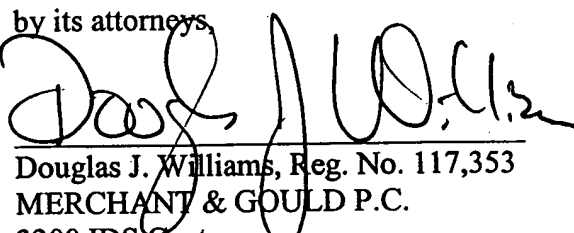
NOTICE OF VOLUNTARY DISMISSAL WITHOUT PREJUDICE
PURSUANT TO FED.R.CIV.P. 41(a)(1)

Plaintiff Ecolab Inc. filed its Complaint in the above-named action on February 21, 2003. The adverse parties have not yet filed an answer or a motion for summary judgment. Pursuant to Federal Rule of Civil Procedure 41(a)(1)(i), Ecolab files this notice to voluntarily dismiss its action against the above-named defendants without prejudice.

ECOLAB INC.,

by its attorneys,

Dated: July 6, 2003


Douglas J. Williams, Reg. No. 117,353
MERCHANT & GOULD P.C.
3200 IDS Center
80 South Eighth Street
Minneapolis, Minnesota 55402-2215
Telephone No. 612.336.4632

OF COUNSEL:

Andrew Sorensen, Esq.

ECOLAB INC.

Ecolab Center

370 North Wabasha Street

St. Paul, Minnesota 55102

Telephone No. 612.293.2432

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RECEIVED

JUN 25 2004

IN THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF MINNESOTA

CLERK
U.S. DISTRICT COURT
MINNEAPOLIS, MINNESOTA

ECOLAB INC.,

Plaintiff,

v.

PESTWEST ELECTRONICS LTD.

and

PESTWEST USA, LLC,

Defendants.

Civil No. 04-CV-3049JMR/FLN

Judge _____

Magistrate Judge _____

JURY TRIAL DEMAND

COMPLAINT

Comes now the Plaintiff, and for its Complaint against Defendants, states and alleges as follows:

THE PARTIES

1. Plaintiff, Ecolab Inc., is incorporated in the State of Delaware, having a principal place of business at Ecolab Center, 370 North Wabasha Street, St. Paul, Minnesota 55102.
2. Upon information and belief, Defendant, PestWest Electronics Ltd., is a foreign limited liability company, having a principal place of business at Denholme Drive, Ossett, West Yorkshire, WF5 9NB, UK.
3. Upon information and belief, Defendant, PestWest USA, LLC, is incorporated in the State of South Carolina, having its registered office at 104 South Main Street, Suite 900, Greenville, South Carolina 29601, and its principal place of business at 6934 Riversedge Street Circle, Bradenton, Florida 34202-4018.
4. Plaintiff is engaged in the business of manufacturing, distributing, and selling a wide variety of cleaning and sanitizing products and services including pest elimination products

and services to a wide variety of customers including hotels, restaurants, health care facilities, food and beverage processing plants, and others.

5. Plaintiff Ecolab has been a leader in the institutional commercial pest elimination business and a leader in program and technological product innovations, such as its Ecolab Flying Insect Defense Program and its Stealth® Fly System.

6. Defendants PestWest Electronics Ltd. and Pest West USA, LLC, are engaged, inter alia, in the business of importing into and selling in the United States pest elimination products including flying insect control equipment for similar applications.

JURISDICTION

7. This is a claim of patent infringement arising under the Acts of Congress relating to patents, 35 U.S.C. §§ 271 and 282-85.

8. This Court has jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

9. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391 and 1400.

COUNT I - PATENT INFRINGEMENT

10. On November 22, 1994, United States Patent No. 5,365,690 (hereinafter "the '690 patent") entitled ADHESIVE LIGHT TRAP was duly and legally issued to Plaintiff; and since that date Plaintiff has been, and still is, the owner of the '690 patent. A copy of the '690 patent is attached hereto as Exhibit A.

11. On March 3, 1998, Reexamination Certificate B1 5,365,690 was duly and legally issued, confirming the patentability of claims 1-5, 7-10, 13-19, and 21-24. New claims 25-26 were added to the '690 patent. A copy of Reexamination Certificate B1 5,365,690 is attached hereto as Exhibit B.

12. On October 16, 1998, the United States District Court for the District of Minnesota entered a final judgment by consent decree in *Ecolab Inc. v. Gilbert Industries, Inc.*, Civil Action No. 3-94-1505, that the '690 patent is a valid pioneering patent. A copy of the final judgment in that case is attached hereto as Exhibit C.

13. On December 5, 2002, a jury empanelled in the United States District Court for the District of Minnesota rendered a verdict in *Ecolab Inc. v. Gardner Manufacturing Company, Inc.*, Civil Action No. 98-2294, upholding the validity of the '690 patent. Copies of the special verdict forms and final judgment rendered in that case are attached hereto as Exhibit D.

14. On April 9, 1996, United States Patent No. 5,505,017 (hereinafter "the '017 patent") entitled FLYING INSECT TRAP USING REFLECTED AND RADIATED LIGHT was duly and legally issued to Plaintiff; and since that date Plaintiff has been, and still is, the owner of the '017 patent. A copy of the '017 patent is attached hereto as Exhibit E.

15. On December 17, 2002, United States Patent No. 6,493,986 B1 (hereinafter "the '986 patent") entitled LIGHT TRAP FOR INSECTS was duly and legally issued to Plaintiff; and since that date Plaintiff has been, and still is, the owner of the '986 patent. A copy of the '986 patent is attached hereto as Exhibit F.

16. Defendants PestWest Electronics Ltd. and Pest West USA, LLC, have infringed the '690 and '017 patents through the manufacture, importation, use, sale and/or offer for sale of flying insect traps including, but not limited to, the Mantis Uplight decorative insect light trap. A copy of the PestWest USA web page depicting and describing the Mantis Uplight is attached hereto as Exhibit G.

17. Plaintiff has been damaged by Defendants' infringement of said patents and will continue to be damaged in the future unless Defendants are permanently enjoined from infringing said patents, inducing infringements of said patents, and contributing to the infringement of said patents by others.

18. Upon information and belief, Defendants are aware that the '690 and '017 patents were duly and legally issued and that Defendants' use, manufacture, importation, and sale of the above-identified flying insect traps infringes said patents.

19. Upon information and belief, the Defendants' infringement of said patents is now and has been intentional, willful, and deliberate, and will continue unless enjoined by the Court.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays for judgment that:

A. United States Patent Nos. 5,365,690, 5,505,017, and 6,493,986 B1 are valid and have been infringed by Defendants.

B. Defendants, their officers, agents, servants and employees and those persons in active concert or participation with any of them be enjoined from further infringement of United States Patent Nos. 5,365,690, 5,505,017, and 6,493,986 B1.

C. An accounting be had for the profits and damages arising out of Defendants' infringement of United States Patent Nos. 5,365,690, 5,505,017, and 6,493,986 B1, including treble damages for willful infringement as provided by Title 35 U.S.C. § 284, with interest;

D. Defendants be preliminarily and permanently enjoined from continued use, importation, or sale of Defendants' product used to infringe said patents;

E. Plaintiff be awarded its attorneys' fees, costs, and expenses in this action; and

F. Plaintiff be awarded such relief as this Court may deem necessary and proper.

DEMAND FOR JURY TRIAL

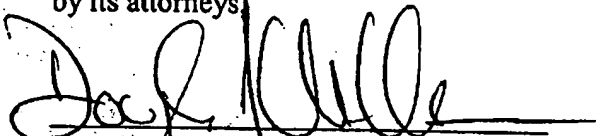
Plaintiff hereby demands a trial by jury of all issues so triable.

Respectfully submitted,

ECOLAB INC.

by its attorneys

Dated: 6/25/04



Douglas A. Williams, Reg. No. 117,353
Rebecca A. Bortolotti, Reg. No. 309,631
Rachel K. Zimmerman, Reg. No. 314,171
Rachel Clark Hughey, Reg. No. 328,042
MERCHANT & GOULD P.C.
3200 IDS Center
80 South Eighth Street
Minneapolis, Minnesota 55402-2215
Telephone: 612.332.5300

OF COUNSEL:

Andrew Sorensen, Esq.

ECOLAB INC.

Ecolab Center

370 North Wabasha Street

St. Paul, Minnesota 55102

Telephone: 612.293.2432



US005365690A

United States Patent [19]

Nelson et al.

[11] Patent Number: 5,365,690

[45] Date of Patent: Nov. 22, 1994

[54] **FLYING INSECT TRAP USING REFLECTED AND RADIATED LIGHT**[75] Inventors: Thomas D. Nelson, Maplewood;
Douglas G. Anderson, Lakeville, both
of Minn.

[73] Assignee: Ecolab, Inc., St. Paul, Minn.

[21] Appl. No.: 264

[22] Filed: Jan. 4, 1993

[51] Int. Cl.⁵ A01M 1/04

[52] U.S. Cl. 43/113; 43/114

[58] Field of Search 43/112, 113, 114

[56] **References Cited****U.S. PATENT DOCUMENTS**

| | | | |
|------------|---------|-----------------------|---------|
| D. 325,954 | 5/1992 | Lazzeroni, Sr; et al. | D22/123 |
| 1,009,580 | 11/1911 | Robinson | 43/113 |
| 1,304,397 | 5/1919 | Saad | 43/113 |
| 2,645,877 | 7/1953 | Pohlman | 43/113 |
| 4,117,624 | 10/1978 | Phillips | 43/113 |
| 4,141,173 | 2/1979 | Weimert | 43/113 |
| 4,332,100 | 6/1982 | Schneider | 43/113 |
| 4,490,937 | 1/1985 | Yavnieli | 43/112 |
| 4,696,126 | 9/1987 | Grothaus et al. | 43/112 |
| 4,876,822 | 10/1989 | White | 43/113 |
| 4,949,501 | 8/1990 | Larkin | 43/113 |
| 4,959,923 | 10/1990 | Alello et al. | 43/112 |

OTHER PUBLICATIONS

"Electronics, adhesive offer sanitary fly control", Com-

petitive Literature Review, Publication: Pest Control, Nov. 1992.

Micro-Gen Introduces: The Vector™ Fly System products literature.

Gilbert Insect Light Traps product literature.

"Effect of Components on Insect Light Trap Performance", J. P. Hollingsworth et al., Transactions of the American Society of Agricultural Engineers, vol. 15, No. 5, pp. 924-927.

"Design Parameters that Affect the Performance of UV-emitting Traps in Attracting House Flies (Diptera: Muscidae)", L. G., Pickens et al., Journal of Economic Entomology, vol. 79, No. 4, Aug. 1986, pp. 1003-1009.

I-O-C™ Insect-O-Cutor product literature.

Venus Flylite™ product literature.

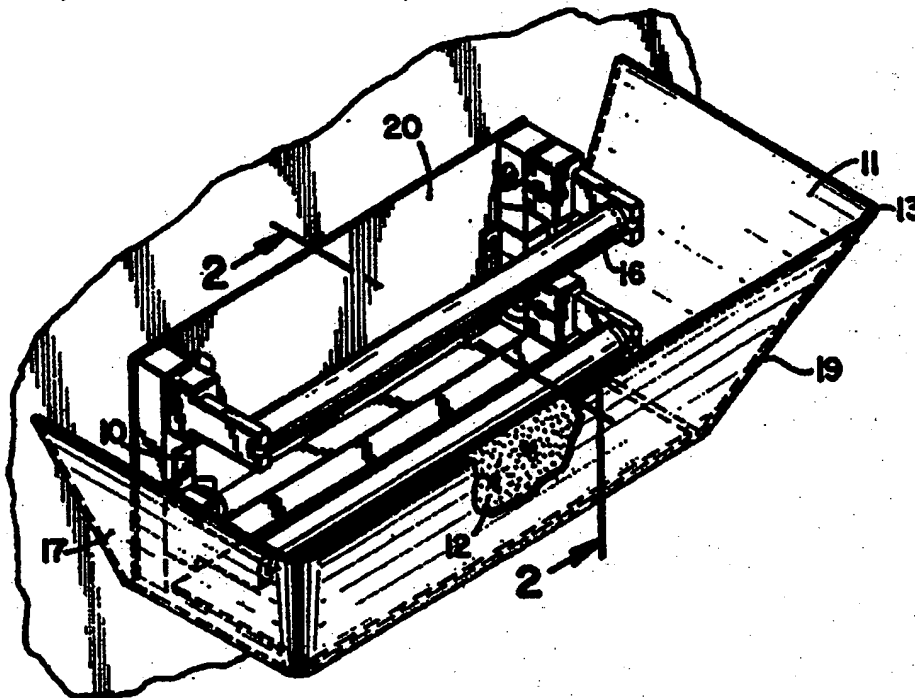
Primary Examiner—Kurt C. Rowan

Attorney, Agent, or Firm—Merchant, Gould, Smith, Edell, Welter & Schmidt

[57] **ABSTRACT**

An insect trap using attractant light, comprising a source of light and a housing can be mounted on a vertical surface or placed near a ceiling surface. The housing and the source of light cooperate to form an upwardly facing opening for the facilitated entry of flying insect pests and for the reflection of light onto the vertical surface. Insects that enter the trap are immobilized on a surface within the trap. Cooperation between direct radiant light, reflected light and an upwardly facing entrance for insects substantially increase capture rates.

24 Claims, 1 Drawing Sheet

**EXHIBIT**A

REEXAMINATION CERTIFICATE ISSUED UNDER 35 U.S.C. 307

THE PATENT IS HEREBY AMENDED AS
INDICATED BELOW.

Matter enclosed in heavy brackets [] appeared in the patent, but has been deleted and is no longer a part of the patent; matter printed in italics indicates additions made to the patent.

AS A RESULT OF REEXAMINATION, IT HAS BEEN
DETERMINED THAT:

The patentability of claims 1-5, 7-10, 13-19, 21, 22, 23
and 24 is confirmed.

Claims 6, 11, 12 and 20 are cancelled.

New claims 25-26 are added and determined to be
patentable.

25. A flying insect trap that uses a display of insect
attractant light on a vertical mounting surface, said trap
comprising:

- (a) a means for mounting a flying insect trap on a vertical
mounting surface;
- (b) a source of insect attractant light; and
- (c) a housing enclosing the source, said housing compris-
ing:
 - (i) an internal reflecting surface of the housing, posi-
tioned with respect to the horizontal such that both

effective reflected and effective radiated light from
the source of insect attractant light is directed onto
the vertical mounting surface forming a diffused
insect attracting light pattern; and
an insect immobilization surface; wherein the housing
comprises an upwardly facing opening for insect
entry and the insect attractant light source is placed
in the housing below an edge of the upwardly facing
opening.

26. A flying insect trap that uses a display of insect
attractant lights reflected and radiated onto a vertical mount-
ing surface, said trap comprising:

- (a) a means for mounting a flying insect trap on a vertical
mounting surface;
- (b) a source of insect attractant light; and
- (c) a housing enclosing the source, said housing compris-
ing:
 - (i) an internal reflecting surface of the housing, posi-
tioned with respect to the horizontal such that light
from the source of insect attractant light is directed
onto the vertical mounting surface forming a diffused
light pattern; and
 - (ii) an insect immobilization surface;
wherein the housing comprises an upwardly facing
opening for insect entry and the insect attractant light
source is placed in the housing below an edge of the
upwardly facing opening and wherein the housing
surrounds the source such that substantially all fly
attracting light exits the trap through the upwardly
facing opening.

* * * * *

IN THE UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF MINNESOTA

ECOLAB INC.,

Plaintiff,

v.

GILBERT INDUSTRIES, INC.,

Defendant.

Civil No. 3-94-1505

Honorable Judge Kyle
Magistrate Judge Mason

FINAL JUDGMENT

The parties having agreed to the entry of this Final Judgment, according to the terms contained herein, the Court hereby finds, orders, adjudges and decrees that:

Findings of Fact and Conclusions of Law

1. This Court has jurisdiction over the parties to this action and over the subject matter of the pleadings. Venue is also proper in this forum.
2. Plaintiff, Ecolab Inc. ("Ecolab"), is a Delaware Corporation having its principal place of business at Ecolab Center, St. Paul, MN 55102.
3. Defendant, Gilbert Industries, Inc. ("Gilbert"), is an Arkansas Corporation having its principal place of business at 5611 Krueger Drive, Jonesboro, Arkansas, 72401-6818.
4. Ecolab has sued Gilbert for patent infringement of U.S. Patent No. 5,365,690 and Re-Examination Certificate No. 3451 (collectively "the '690 patent"), by virtue of Gilbert's sale of its product line under the trademark "FLYING VENUS®".
5. This action was filed on November 22, 1994 and in response, Gilbert denied that Ecolab's patent was valid, denied that it infringed the '690 patent, and sought reexamination of Ecolab's patent in the U.S. Patent and Trademark Office. Gilbert sought to stay this

FILED _____
FRANCIS E. DOSAL, CLERK
JUDGMENT ENTD. _____
DEPUTY CLERK _____

EXHIBIT

C

action in favor of the re-examination proceeding in the U.S. Patent and Trademark Office challenging Ecolab's patent, and as a result this action was stayed on November 13, 1995.

6. In the re-examination proceeding, the U.S. Patent and Trademark Office could only address "new issues" of patentability with respect to the original patent claims. However, with respect to re-examination claims 25 and 26, which were newly submitted during the proceedings in the U.S. Patent and Trademark Office, the Patent Office considered these claims against all prior art and was not limited to only considering new issues of patentability.
7. The U.S. Patent and Trademark Office concluded that Ecolab's patent claims subject to the re-examination proceeding were patentable and that newly presented claims 25 and 26 were patentable as submitted without further amendment.
8. Subsequent to the re-examination proceeding, Gilbert continued to assert that the claims of the '690 patent were not infringed by Gilbert, arguing that certain statements made in the patent's specification and in the file history should be read into the language of the patent's claims as specific claim limitations.
9. Gilbert filed a motion for summary judgment pursuing these and other arguments, which was briefed and argued before United States Magistrate Judge John M. Mason. On June 16, 1998, Magistrate Judge Mason issued his Report and Recommendation denying Gilbert's summary judgment motion.
10. Gilbert objected to the Report and Recommendation, and the parties fully briefed the issue before this Court.
11. This Court conducted a *de novo* review of the proceedings and adopted the Report and Recommendation and denied Gilbert's motion for summary judgment on August 11, 1998.
12. In denying Gilbert's motion, this Court concluded, at page 9 of the Report and Recommendation, that "[n]o special meaning is claimed for any of the terms in the patent,

so the words should be given the ordinary and common meaning by which they would be understood by a person skilled in the art".

13. Consequently, the plain meaning of the claims controls and it is improper to insert further limitations which do not explicitly appear in the text of the claims.
14. In view of the proceedings in the Patent and Trademark Office and before this Court, the Court construes the claims of the Ecolab '690 patent to have no different meaning than their plain, ordinary language presents and rules that the claims are not subject to further limitations not appearing in the claims.
15. Consequently, the Court finds and concludes and Gilbert agrees that its "Flying Venus" products which it has heretofore manufactured, infringe Ecolab's '690 patent.
16. Based upon the recommendation, pleadings and the proceedings before this Court, the Court finds and concludes and Gilbert agrees that the '690 patent is a valid patent.
17. This Court finds and concludes and Gilbert agrees that the invention of the '690 patent is a pioneering invention entitled to a broad scope of equivalents.
18. Subject to the additional conditions in the following paragraph, Gilbert agrees that as of the date of this Final Judgment, it will not make, use, sell, offer for sale, or import an insect trap product that uses an attractive pattern of light displayed on a wall, vertical mounting surface, or equivalent surface above the trap.
19. Any trap that does not direct a display of light of more than 3.5 footcandles of total reflected and radiated light upon the wall, vertical mounting surface, or equivalent surface, above the trap is excluded from the injunction of this judgment. Conversely, a trap of the general configuration of the Gilbert FLYING VENUS® or the Ecolab STEALTH® which creates a display of light of more than 3.5 footcandles of total reflected and radiated light, regardless of the specific amount of each individual component of light, upon the wall, vertical mounting surface, or equivalent, above the trap falls within the scope of Ecolab's broad '690 patent claims.

20. Gilbert agrees not to assert that it does not infringe the '690 patent by virtue of an argument that the claims are limited, beyond the literal wording of the claims, to some structure, limit, value, or the like, from the '690 patent or application history, including re-examination history, and prior art, including, but not limited to, such alleged limitations as:
- a) a specific angle for the internal geometry of a trap;
 - b) a specific amount of light that forms the pattern of light adjacent the trap;
 - c) the color or degree of reflectiveness of any of the internal surfaces of the trap;
 - d) the size, dimension or general shape of the trap; and/or
 - e) any other limitation, or narrowing definition, which contradicts the plain meaning of the words of the patent claims themselves or is not otherwise specifically recited in the claims.
21. Ecolab agrees that it will not charge any Gilbert product depicted in Catalog ILT Cat 1195 of Gilbert Industries, Inc. (Attachment A hereto), other than the 115GT/215GT "Flying Venus" Wall Sconce Fly Trap shown on pages 3 and 14 of Attachment A, as an infringement of the '690 patent.
22. If in violation of this judgment or of Ecolab's '690 patent, Gilbert makes, uses, sells, offers for sale, or imports a product which is the subject of litigation and which is not dismissed on a motion for summary judgment, Gilbert shall pay to Ecolab \$650,000.00 within thirty (30) days of the date upon which the time to file any dispositive motions elapses or within thirty (30) days of an adverse decision to Gilbert on any such summary judgment motion.
23. Gilbert must pay damages to Ecolab for the aforementioned infringement in the amount of \$800,000.00 in accordance with this Judgment as full compensation for its infringement in this action.
24. Gilbert is aware of the Federal Circuit Court of Appeals decision in *Foster v. Halco*, 20 U.S.P.Q. 2d 1241 (Fed. Cir. 1991), and hereby waives all right to contest validity of

Ecolab's '690 patent including in any proceedings of any type, involving its current products or any future products regardless of whether they are characterized as otherwise, new, different, not-infringing or the like, at all times in the future. Further, Gilbert will not assist others in any way, in any proceeding of any type, in contesting the validity of the '690 patent unless compelled to do so by a lawful Consent Order.

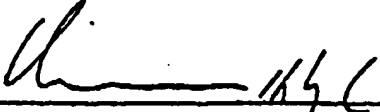
ORDER

This Court hereby orders that:

25. Gilbert, its agents, servants, employees, attorneys, assignees and all persons controlling or in active concert or participation with, through or under them are hereby enjoined:
 - a) from infringing any claims of U.S. Patent No. 5,365,690 and Re-examination Certificate No. 3451; and
 - b) from causing, inducing or contributing to the infringement of the same by others.
26. The respective parties hereby shall pay their own costs, disbursements and attorneys' fees. The clerk is directed to enter this Final Judgment forthwith.

SO ORDERED

10/16/98
Date


U.S. Judge Richard H. Kyle

for GILBERT INDUSTRIES, INC.

for ECOLAB INC.

Steven H. Noll
Steven H. Noll
Hill & Simpson
85th Floor, Sears Tower
Chicago, IL 60606
(312) 876-0200
10-14-98

Norman Friederichs, 32,128
Friederichs Law Firm, plc.
1295 Fifth Street Towers
100 South Fifth Street
Minneapolis, MN 55402
(612) 333-0022

Douglas J. Williams 10/13/98
Douglas J. Williams, 117,353
Merchant, Gould, Smith, Edell, Welter & Schmidt
3100 Northwest Center
90 South Seventh Street
Minneapolis, MN 55402
(612) 332-5300

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

ECOLAB INC.,

Plaintiff,

Vs.

Civil Action No. 98-2294 (MJD/JGL)

GARDNER MANUFACTURING CO., INC.,

Defendant.

SECTION I--Validity

1. Anticipation

Has Gardner proven by clear and convincing evidence that the subject matter covered by claims 18 or 26 of the '690 patent are anticipated by the prior art?

a) Claim 18 Yes _____ No X
b) Claim 26 Yes _____ No X

2. Obviousness

Has Gardner proven by clear and convincing evidence that the subject matter of claims 18 or 26 of the '690 patent would have been obvious to one of ordinary skill in the art as of January 4, 1992?

a) Claim 18 Yes _____ No X
b) Claim 26 Yes _____ No X

3. Indefiniteness

Has Gardner proven by clear and convincing evidence that claims 18 or 26 of the '690 patent are invalid for indefiniteness?

a) Claim 18 Yes _____ No X
b) Claim 26 Yes _____ No X

344



FILED 12-5-02
RICHARD D. SLETTEN, CLERK
JUDGMENT ENTERED
DEPUTY CLERK

4. On Sale Bar

Has Gardner proven by clear and convincing evidence that claims 18 or 26 of the '690 patent are invalid because the subject matter of the claims was on sale prior to January 4, 1992?

a) Claim 18 Yes _____

No X

b) Claim 26 Yes _____

No X

SECTION II--Infringement:

1. WS-50

A) Has Ecolab proven by a preponderance of the evidence that the WS-50 contains each and every element of both claims 16 and 18 of the '690 Patent?

yes
(Yes or No)

B) Has Ecolab proven by a preponderance of the evidence that the WS-50 contains the equivalence of each and every element of both claims 16 and 18 of the '690 Patent?

yes
(Yes or No)

C) Has Ecolab proven by a preponderance of the evidence that the WS-50 contains each and every element of claim 26 of the '690 Patent?

yes
(Yes or No)

D) Has Ecolab proven by a preponderance of the evidence that the WS-50 contains the equivalence of each and every element of claim 26 of the '690 Patent?

yes
(Yes or No)

2. WS-75

A) Has Ecolab proven by a preponderance of the evidence that, when the metal plate does not cover the light bulb, the WS-75 contains each and every element of both claims 16 and 18 of the '690 Patent?

NO
(Yes or No)

B) Has Ecolab proven by a preponderance of the evidence that, when the metal plate does not cover the light bulb, the WS-75 contains the equivalence of each and every element of both claims 16 and 18 of the '690 Patent?

NO
(Yes or No)

C) Has Ecolab proven by a preponderance of the evidence that, when the metal plate does not cover the light bulb, the WS-75 contains each and every element of claim 26 of the '690 Patent?

yes
(Yes or No)

D) Has Ecolab proven by a preponderance of the evidence that, when the metal plate does not cover the light bulb, the WS-75 contains the equivalence of each and every element of claim 26 of the '690 Patent?

yes
(Yes or No)

SECTION III—Inducement

Has Ecolab proven by a preponderance of the evidence that Gardner actively induced its customers to use the WS-75 with the metal plate raised, and would such use infringe claims 18 or 26 of the '690 patent?

| | | |
|-------------|-----------|-------------|
| a) Claim 18 | Yes _____ | No <u>X</u> |
| b) Claim 26 | Yes _____ | No <u>X</u> |

SECTION IV – Contributory Infringement

Has Ecolab proven by a preponderance of the evidence that Gardner contributorily infringed claims 18 or 26 of the '690 patent?

a) Claim 18 Yes X No
b) Claim 26 Yes X No

SECTION V--Willfulness

Has Ecolab proven by clear and convincing evidence that Gardner willfully infringed the '690 patent?

NO
(Yes or No)

SECTION VI--Marking

Has Ecolab proven by a preponderance of the evidence that Gardner marked its products with U.S. Patent No. 4,876,822 for the purpose of deceiving the public?

NO
(Yes or No)

DATE: December 5, 2002

Foreperson: Sue Beaudette

~~AO450 (Rev. 1/85) Judgment in a Civil Case~~

UNITED STATES DISTRICT COURT
District of Minnesota

Ecolab, Inc.

JUDGMENT IN A CIVIL CASE

V.

Case Number: 98-2294 MJD/JGL

Gardner Manufacturing Co., Inc. and
Guardian Pest Control, Inc.

- ☒ **Jury Verdict.** This action came before the Court for a trial by jury. The issues have been tried and the jury rendered its verdict.
- ☐ **Decision by Court.** This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED THAT:

Judgment is hereby entered in favor of the plaintiff, Ecolab, Inc., and against the defendant, Gardner Manufacturing Co., Inc. in the amount of nine hundred fifty-eight thousand fifty and 75/100 dollars (\$958,050.75).


MICHAEL J. DAVIS, JUDGE U.S. DISTRICT COURTJanuary 29, 2003
DateRICHARD D. SLETTEN, CLERK
(87) Julie M. Rustad, Deputy ClerkFILED _____
RICHARD D. SLETTEN, CLERK
JUDGMENT ENTERED _____
DEPUTY CLERK _____

Modified 01/09/03

UNITED STATES PATENT AND TRADEMARK OFFICE
Certificate

Patent No. 6,493,986 B1

Patented: December 17, 2002

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without any deceptive intent, improperly sets forth the inventorship.

Accordingly, it is hereby certified that the correct inventorship of this patent is: Thomas D. Nelson, Maplewood, MN; and Douglas G. Anderson, Lakeville, MN.

Signed and Sealed this Fifteenth Day of July 2003.

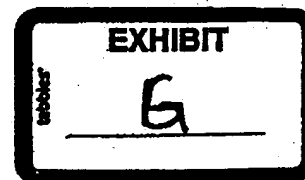
PETER M. POON
Supervisory Patent Examiner
Art Unit 3643

Mantis® Uplight

- Area coverage 420ft²
- 1 x 15 watt bulb
- Shatterproof bulbs optional
- Glue board
- Tool-free servicing
- Wall-mounted
- 8.3" high / 18.5" wide / 6.5" deep
- Weighs 3.7kg
- Magnolia powder-coated zintec steel
- UL Approval



Add to basket



UNITED STATES DISTRICT COURT

DISTRICT OF MINNESOTA

Ecolab Inc.

Plaintiff,

v.

PestWest Electronics LTD.
and PestWest USA, LLC

Defendant.

SUMMONS IN A CIVIL ACTION

CASE NUMBER: 04cv3049 JMR/I

TO:

PestWest USA, LLC
104 South Main Street
Suite 900
Greenville, South Carolina 29601

YOU ARE HEREBY SUMMONED and required to file with the Clerk of this Court and serve upon PLAINTIFFS ATTORNEY:

Douglas J. Williams, Esq.
Merchant & Gould P.C.
3200 IDS Center
Minneapolis, MN 55402
612/332-5300

an answer to the complaint which is herewith served upon you, within 20 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint.

RICHARD D. SLETTEN

CLERK

JUN 25 2004

DATE

BY DEPUTY CLERK

Mary Kaye Coxery

RETURN OF SERVICE

Service of the Summons and Complaint was made by me¹

NAME OF SERVER (PRINT): _____

TITLE: _____

DATE: _____

Check one box below to indicate appropriate method of service:

☐ Served personally upon the defendant. Place where served: _____

☐ Left copies thereof at the defendant's dwelling house or usual place of abode with a person of suitable age and discretion then residing therein. Name of person with whom the summons and complaint were left: _____

☐ Returned unexecuted: _____

☐ Other (specify): _____

STATEMENT OF SERVICE FEES

TRAVEL: _____ SERVICES: _____ TOTAL: _____

DECLARATION OF SERVER

I declare under penalty of perjury under the laws of the United States of America that the foregoing information contained in the Return of Service and Statement of Service Fees is true and correct.

Executed on: _____

DATE

Signature of Server _____

Address of Server _____

UNITED STATES DISTRICT COURT

DISTRICT OF MINNESOTA

Ecolab Inc.

SUMMONS IN A CIVIL ACTION

CASE NUMBER: 04cv3049 JMR/F

Plaintiff,

v.

PestWest Electronics LTD.
and PestWest USA, LLC

Defendant.

TO: PestWest Electronics Ltd.
Denholme Drive
Ossett, West Yorkshire
WF5 9NB
UNITED KINGDOM

YOU ARE HEREBY SUMMONED and required to file with the Clerk of this Court and serve upon PLAINTIFFS ATTORNEY:

Douglas J. Williams, Esq.
Merchant & Gould P.C.
3200 IDS Center
Minneapolis, MN 55402
612/332-5300

an answer to the complaint which is herewith served upon you, within 20 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint.

RICHARD D. SLETTEN
CLERK

JUN 25 2004

DATE

BY DEPUTY CLERK

Mary Kaye Coxery

RETURN OF SERVICE

Service of the Summons and Complaint was made by me¹

NAME OF SERVER (PRINT): _____

TITLE: _____

DATE: _____

Check one box below to indicate appropriate method of service:

☐ Served personally upon the defendant. Place where served: _____

☐ Left copies thereof at the defendant's dwelling house or usual place of abode with a person of suitable age and discretion then residing therein. Name of person with whom the summons and complaint were left: _____

☐ Returned unexecuted: _____

☐ Other (specify): _____

STATEMENT OF SERVICE FEES

TRAVEL: _____ SERVICES: _____ TOTAL: _____

DECLARATION OF SERVER

I declare under penalty of perjury under the laws of the United States of America that the foregoing information contained in the Return of Service and Statement of Service Fees is true and correct.

Executed on: _____
DATE

Signature of Server _____

Address of Server _____

**UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA**

ECOLAB, INC.,
a Delaware corporation,

Court File No. 04-3049 JMR/FLN

Plaintiff,

vs.

**DEFENDANTS' ANSWER
AND COUNTERCLAIMS**

PESTWEST ELECTRONICS, LTD.,
and PESTWEST USA, LLC,

Defendants.

Defendants PestWest Electronics, LTD. and PestWest USA, LLC (collectively "Defendants"), by and through their counsel, hereby jointly answer Plaintiff Ecolab, Inc.'s ("Plaintiff") Complaint as follows:

ANSWER TO COMPLAINT

1. Defendants are without sufficient knowledge or information to admit the truth of the allegations contained in Paragraph 1 of Plaintiff's Complaint, and therefore deny the same.

2. Defendants admit the information contained in Paragraph 2 of Plaintiff's Complaint.

3. Defendants state only that PestWest USA, LLC is incorporated in the state of South Carolina, with the registered agent being listed at the address provided by Plaintiff. Defendants deny the remaining allegations contained in Paragraph 3 of Plaintiff's Complaint.

4. Defendants are without sufficient knowledge or information to admit the truth of the allegations contained in Paragraph 4 of Plaintiff's Complaint, and therefore deny the same.

5. Defendants are without sufficient knowledge or information to admit the truth of the allegations contained in Paragraph 5 of Plaintiff's Complaint, and therefore deny the same.

6. Defendants state that the Mantis Uplight fly traps are imported into and sold in the United States. Defendants are without sufficient knowledge and information to form a belief as to the meaning of the phrase "are engaged, inter alia, in the business of importing into and selling in the United States pest elimination products including flying insect control equipment for similar application" as contained in Paragraph 6 of Plaintiff's Complaint, and therefore deny all allegations regarding that phrase.

7. Defendants admit that Plaintiff has alleged patent infringement under 35 U.S.C. §§ 271 and 282-85. Defendants deny the merits of the patent infringement allegations contained in Paragraph 7 of Plaintiff's Complaint.

8. Defendants do not dispute that subject matter jurisdiction is proper with this Court.

9. Defendants do not dispute that personal jurisdiction and venue are proper with this Court.

10. Defendants state only that the face of U.S. Patent No. 5,365,690 ("the '690 Patent") speaks for itself. Defendants deny that the '690 Patent was duly and legally issued. Defendants are without sufficient knowledge or information to admit the truth of the remaining allegations contained in Paragraph 10 of Plaintiff's Complaint, and therefore deny the same.

11. Defendants state only that the face of the 1998 Reexamination Certificate for the '690 Patent speaks for itself and, therefore, Defendants deny the allegations contained in Paragraph 11 of Plaintiff's Complaint.

12. Defendants state only that the final judgment in the *Ecolab, Inc. v. Gilbert Industries, Inc.* Civil Action speaks for itself and, therefore, Defendants deny the allegations contained in Paragraph 12 of Plaintiff's Complaint.

13. Defendants state only that the jury verdict in the *Ecolab, Inc. v. Gardner Mfg. Co.* Civil Action speaks for itself and, therefore, Defendants deny the allegations contained in Paragraph 13 of Plaintiff's Complaint.

14. Defendants state only that the face of U.S. Patent No. 5,505,017 ("the '017 Patent") speaks for itself. Defendants deny that the '017 Patent was duly and legally issued. Defendants are without sufficient knowledge or information to admit the truth of the remaining allegations contained in Paragraph 14 of Plaintiff's Complaint, and therefore deny the same.

15. Defendants state only that the face of U.S. Patent No. 6,493,986 B1 ("the '986 Patent") speaks for itself. Defendants deny that the '986 Patent was duly and legally issued. Defendants are without sufficient knowledge or information to admit the truth of the remaining allegations contained in Paragraph 15 of Plaintiff's Complaint, and therefore deny the same.

16. Defendants deny the allegations contained in Paragraph 16 of Plaintiff's Complaint.

17. Defendants deny the allegations contained in Paragraph 17 of Plaintiff's Complaint.

18. Defendants deny the allegations contained in Paragraph 18 of Plaintiff's Complaint.

19. Defendants deny the allegations contained in Paragraph 19 of Plaintiff's Complaint.

DEFENSES AND AFFIRMATIVE DEFENSES

Defendants assert the following defenses and affirmative defenses:

20. Plaintiff fails to state a claim against Defendants upon which relief can be granted.

21. Defendants have neither directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '690 Patent or the '017 Patent.

22. The '690 Patent and the '017 Patent are invalid for failure to meet the conditions of patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and/or failure to comply with the requirements of 35 U.S.C. §§ 112 and 116, and other applicable statutory sections.

23. The '690 Patent and the '017 Patent are unenforceable for failure to meet the duties and obligations specified in 37 C.F.R. § 1.56, and other applicable statutes and/or regulations, for at least the reasons particularly described and pled in Paragraphs 12 through 36 of Defendants' Counterclaims.

24. Plaintiff's claims against Defendants are barred in whole or in part by the doctrine of patent misuse.

25. Plaintiff's claims against Defendants are barred in whole or in part by Plaintiff's failure to mitigate its damages.

26. Plaintiff's claims against Defendants are barred in whole or in part by Plaintiff's unclean hands.

27. Plaintiff's claims against Defendants are barred in whole or in part because Defendants was and is practicing the prior art.

28. Plaintiff's claims against Defendants are barred in whole or in part by the doctrine of laches, including but not limited to prosecution laches.

29. Plaintiff's claims against Defendants are barred in whole or in part by the doctrine of estoppel.

30. Plaintiff's claims against Defendants are barred in whole or in part by the doctrine of acquiescence.

31. Plaintiff's claims against Defendants are barred in whole or in part by the doctrines of license, waiver, and/or intervening rights.

COUNTERCLAIMS
**DECLARATORY JUDGMENT OF NONINFRINGEMENT, INVALIDITY
AND UNENFORCEABILITY OF THE '690 PATENT,
THE '017 PATENT AND THE '986 PATENT**

For its counterclaims against Plaintiff, Defendants hereby state and allege as follows:

1. Defendants incorporate by reference all of the foregoing allegations and averments of their Answer to Plaintiff's Complaint, and Defendants' Defenses and Affirmative Defenses.

2. These counterclaims are for declaratory judgment of noninfringement, invalidity and unenforceability of the '690 Patent, the '017 Patent and the '986 Patent (collectively "Plaintiff's Patents"). This Court has jurisdiction over these counterclaims under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, in that Plaintiff has accused Defendants of infringing Plaintiff's Patents. Defendants deny Plaintiff's infringement accusations, thereby creating an actual controversy between the parties. This Court has subject matter jurisdiction over Defendants' counterclaims pursuant to 28 U.S.C. §§ 1338(a) and 1367, and Fed.R.Civ.P.

COUNTERCLAIM I
NONINFRINGEMENT OF THE '690 PATENT

3. The accused products made, used, offered for sale, imported, and/or sold by Defendants do not directly infringe, willfully infringe, induce infringement, nor contributorily infringe any claim of the '690 Patent.

4. Defendants have not directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '690 Patent.

COUNTERCLAIM II
INVALIDITY OF THE '690 PATENT

5. The '690 Patent is invalid for failure to meet the conditions of patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and/or failure to comply with the requirements of 35 U.S.C. §§ 112 and 116, and other applicable statutory sections.

COUNTERCLAIM III
NONINFRINGEMENT OF THE '017 PATENT

6. The accused products made, used, offered for sale, imported, and/or sold by Defendants do not directly infringe, willfully infringe, induce infringement, nor contributorily infringe any claim of the '017 Patent.

7. Defendants have not directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '017 Patent.

COUNTERCLAIM IV
INVALIDITY OF THE '017 PATENT

8. The '017 Patent is invalid for failure to meet the conditions of patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and/or failure to comply with the requirements of 35 U.S.C. §§ 112 and 116, and other applicable statutory sections.

COUNTERCLAIM V
NONINFRINGEMENT OF THE '986 PATENT

9. The accused products made, used, offered for sale, imported, and/or sold by Defendants do not directly infringe, willfully infringe, induce infringement, nor contributorily infringe any claim of the '986 Patent.

10. Defendants have not directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '986 Patent.

COUNTERCLAIM VI
INVALIDITY OF THE '986 PATENT

11. The '986 Patent is invalid for failure to meet the conditions of patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and/or failure to comply with the requirements of 35 U.S.C. §§ 112 and 116, and other applicable statutory sections.

COUNTERCLAIM VII
INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '690 PATENT

12. The '690 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

13. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '690 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

14. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '690 Patent, in violation of 37 C.F.R. § 1.56. Specifically, Plaintiff and/or Plaintiff's counsel was aware of the material, non-cumulative teachings and information contained in German Patent No. 3,840,440 as Plaintiff's counsel, Merchant & Gould, P.C., did and/or does represent the patentee for the German Patent in various patent matters. Plaintiff and/or Plaintiff's counsel failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during prosecution of the '690 Patent.

COUNTERCLAIM VIII
INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '017 PATENT

15. The '017 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

16. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '017 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

17. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '017 Patent, in violation of 37 C.F.R. § 1.56. Specifically, Plaintiff and/or Plaintiff's counsel was aware of the

material, non-cumulative teachings and information contained in German Patent No. 3,840,440 as Plaintiff's counsel, Merchant & Gould, P.C., did and/or does represent the patentee for the German Patent in various patent matters. Plaintiff and/or Plaintiff's counsel failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during prosecution of the '017 Patent.

COUNTERCLAIM IX
INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '017 PATENT

18. The '017 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

19. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '017 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

20. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '017 Patent had a duty to disclose the existence of prior or pending litigation involving the subject matter of the '017 Patent in accordance with 37 C.F.R. § 1.56 and the Manual of Patent Examining Procedure ("M.P.E.P.") § 2001.06(c).

21. In the case of *Ecolab, Inc. v. Gilbert Industries, Inc.*, Civil Action No. 3-94-1505 in the United States District Court for the District of Minnesota, Plaintiff claimed, at least in part, that Gilbert Industries, Inc. infringed the '690 Patent.

22. In the case of *Ecolab, Inc. v. Paraclipse, Inc.*, Civil Action No. 94-601 in the United States District Court for the District of Nebraska, Plaintiff claimed, at least in part, that Paraclipse, Inc. infringed the '690 Patent.

23. The '017 Patent is a Continuation of the '690 Patent.

24. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '017 Patent, in violation of 37 C.F.R. § 1.56 and M.P.E.P. § 2001.06(c). Specifically, Plaintiff and/or Plaintiff's counsel was aware of the litigation referenced above in Paragraphs 21 through 22 and failed to disclose the existence of such litigation, and/or any other material information arising therefrom, to the United States Patent and Trademark Office during prosecution of the '017 Patent.

COUNTERCLAIM X
INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '986 PATENT

25. The '986 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

26. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '986 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

27. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '986 Patent, in violation of 37 C.F.R. § 1.56. Specifically, Plaintiff and/or Plaintiff's counsel was aware of the material, non-cumulative teachings and information contained in German Patent No. 3,840,440 as Plaintiff's counsel, Merchant & Gould, P.C., did and/or does represent the patentee for the German Patent in various patent matters. Plaintiff and/or Plaintiff's counsel failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during prosecution of the '986 Patent.

COUNTERCLAIM XI
INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '986 PATENT

28. The '986 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

29. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '986 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

30. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '986 Patent had a duty to disclose the existence of prior or pending litigation involving the subject matter of the '986 Patent in accordance with 37 C.F.R. § 1.56 and M.P.E.P. § 2001.06(c).

31. In the case of *Ecolab, Inc. v. Gilbert Industries, Inc.*, Civil Action No. 3-94-1505 in the United States District Court for the District of Minnesota, Plaintiff claimed, at least in part, that Gilbert Industries, Inc. infringed the '690 Patent.

32. In the case of *Ecolab, Inc. v. Paraclipse, Inc.*, Civil Action No. 94-601 in the United States District Court for the District of Nebraska, Plaintiff claimed, at least in part, that Paraclipse, Inc. infringed the '690 Patent.

33. In the case of *Ecolab, Inc. v. Paraclipse, Inc.*, Civil Action No. 97-304 in the United States District Court for the District of Nebraska, Plaintiff claimed, at least in part, that Paraclipse, Inc. infringed the '690 Patent and the '017 Patent.

34. In the case of *Ecolab, Inc. v. Gardner Manufacturing Co.*, Civil Action No. 00-2294 in the United States District Court for the District of Minnesota, Plaintiff claimed, at least in part, that Gardner Manufacturing Co. infringed the '690 Patent and the '017 Patent.

35. The '986 Patent claims priority to the '690 Patent.

36. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '986 Patent, in violation of 37 C.F.R. § 1.56 and M.P.E.P. § 2001.06(c). Specifically, Plaintiff and/or Plaintiff's counsel was aware of the litigation referenced above in Paragraphs 31 through 34 and failed to disclose the existence of such litigation, and/or any other material information arising therefrom, to the United States Patent and Trademark Office during prosecution of the '986 Patent.

JURY DEMAND

Pursuant to Fed.R.Civ.P. 38(a), Defendants request a trial by jury.

PRAYER FOR RELIEF

WHEREFORE, Defendants respectfully request that this Court:

- (a) Enter judgment dismissing Plaintiff's Complaint with prejudice and on the merits;
- (b) Enter judgment sustaining Defendants' defenses and affirmative defenses;
- (c) Enter judgment declaring that Defendants have neither directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '690 Patent, the '017 Patent and the '986 Patent;
- (d) Enter judgment declaring that the '690 Patent, the '017 Patent and the '986 Patent are invalid;

(e) Enter judgment declaring that the '690 Patent, the '017 Patent and the '986 Patent are unenforceable due to Plaintiff's inequitable conduct;

(f) Grant Defendants their costs in addition to their attorneys' fees, in accordance with 35 U.S.C. § 285, and otherwise according to law; and

(g) Grant Defendants such other relief as the Court may deem just and equitable.

Respectfully submitted,

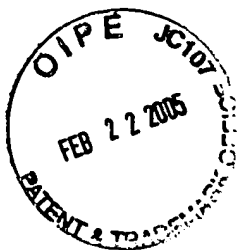
**PATTERSON, THUENTE, SKAAR &
CHRISTENSEN, P.A.**

Dated: December 7, 2004

By: s/Matthew T. Macari
Randall T. Skaar (#165,013)
Matthew T. Macari (#308,717)
Aaron W. Davis (#318,255)
4800 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
Telephone: 612-349-5740

**ATTORNEYS FOR DEFENDANTS
PESTWEST ELECTRONICS, LTD AND
PESTWEST USA, LLC**

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA

ECOLAB INC.,

Plaintiff,

v.

PESTWEST ELECTRONICS LTD. and
PESTWEST USA, LLC,

Defendants.

Civil No. 04-3049 JMR/FLN

PLAINTIFF'S REPLY TO DEFENDANTS' COUNTERCLAIMS

Plaintiff Ecolab Inc. ("Ecolab"), by and through undersigned counsel, hereby replies to the Counterclaims of Defendants PestWest Electronics Ltd. and PestWest USA, LLC (hereinafter collectively "Defendants" or "PestWest") by denying each and every allegation of the Counterclaims unless specifically admitted herein and further replies as follows:

COUNTERCLAIMS

1. Plaintiff states that Paragraph 1 of Defendants' Counterclaims requires no response.
2. With respect to the allegations of Paragraph 2 of Defendants' Counterclaims, Plaintiff admits that Defendants allege counterclaims for declaratory judgment of noninfringement, invalidity and unenforceability. Plaintiff denies that any of Defendants' Counterclaims have merit. Plaintiff does not dispute that this Court has jurisdiction over Defendants' Counterclaims under 28 U.S.C. §§ 2201 and 2202. Plaintiff does not dispute that this Court has subject matter jurisdiction over Defendants' Counterclaims.

COUNTERCLAIM I

3. Plaintiff denies the allegation of Paragraph 3 of Defendants' Counterclaim.
4. Plaintiff denies the allegation of Paragraph 4 of Defendants' Counterclaim.

COUNTERCLAIM II

5. Plaintiff denies the allegation of Paragraph 5 of Defendants' Counterclaim.

COUNTERCLAIM III

6. Plaintiff denies the allegation of Paragraph 6 of Defendants' Counterclaim.
7. Plaintiff denies the allegation of Paragraph 7 of Defendants' Counterclaim.

COUNTERCLAIM IV

8. Plaintiff denies the allegation of Paragraph 8 of Defendants' Counterclaim.

COUNTERCLAIM V

9. Plaintiff denies the allegation of Paragraph 9 of Defendants' Counterclaim.
10. Plaintiff denies the allegation of Paragraph 10 of Defendants' Counterclaim.

COUNTERCLAIM VI

11. Plaintiff denies the allegation of Paragraph 11 of Defendants' Counterclaim.

COUNTERCLAIM VII

12. Plaintiff denies the allegation of Paragraph 12 of Defendants' Counterclaim.
13. With respect to the allegations of Paragraph 13 of Defendants' Counterclaims, Plaintiff states only that 37 C.F.R. § 1.56 speaks for itself. Plaintiff otherwise denies the allegations of Paragraph 13 of Defendants' Counterclaims.

14. With respect to the allegations of Paragraph 14 of Defendants' Counterclaims, Plaintiff denies that it knowingly withheld material information from the United States Patent and Trademark Office during prosecution of the '690 Patent. Plaintiff denies that it violated

37 C.F.R. § 1.56. Plaintiff denies that Plaintiff and/or Plaintiff's counsel was aware of German Patent No. 3,840,440 at any time during the prosecution of any of the patents-in-suit. Plaintiff denies that German Patent No. 3,840,440 contains any material or non-cumulative teachings and/or information. Plaintiff denies that Merchant & Gould represents or has represented the patentee for the German Patent in various patent matters. Plaintiff admits only that at some point in time after the issuance of the '690 Patent, attorneys from Merchant & Gould prosecuted a design patent owned by the patentee of German Patent No. 3,840,440. Plaintiff denies that it failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during the prosecution of the '690 Patent. Plaintiff admits only that a copy of German Patent No. 3,840,440 was not provided to the United States Patent and Trademark Office during the prosecution of the '690 Patent.

COUNTERCLAIM VIII

15. Plaintiff denies the allegations of Paragraph 15 of Defendants' Counterclaims.

16. With respect to the allegations of Paragraph 16 of Defendants' counterclaims, Plaintiff states only that 37 C.F.R. § 1.56 speaks for itself. Plaintiff otherwise denies the allegations of Paragraph 16 of Defendants' Counterclaims.

17. With respect to Paragraph 17 of Defendants' Counterclaims, Plaintiff denies that it knowingly withheld material information from the United States Patent and Trademark Office during prosecution of the '017 Patent. Plaintiff denies that it violated 37 C.F.R. § 1.56. Plaintiff denies that Plaintiff and/or Plaintiff's counsel was aware of German Patent No. 3,840,440 at any time during the prosecution of any of the patents-in-suit. Plaintiff denies that German Patent No. 3,840,440 contains any material or non-cumulative teachings and/or information. Plaintiff denies that Merchant & Gould represents or has represented the patentee for the German Patent

in various patent matters. Plaintiff admits only that at some point in time, attorneys from Merchant & Gould prosecuted a design patent owned by the patentee of German Patent No. 3,840,440. Plaintiff denies that it failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during the prosecution of the '017 Patent. Plaintiff admits only that a copy of German Patent No. 3,840,440 was not provided to the United States Patent and Trademark Office during the prosecution of the '017 Patent.

COUNTERCLAIM IX

18. Plaintiff denies the allegations of Paragraph 18 of Defendants' Counterclaims.

19. With respect to the allegations of Paragraph 19 of Defendants' Counterclaims, Plaintiff states only that 37 C.F.R. § 1.56 speaks for itself. Plaintiff otherwise denies the allegations of Paragraph 19 of Defendants' Counterclaims.

20. With respect to Paragraph 20 of Defendants' Counterclaims, Plaintiff states only that 37 C.F.R. § 1.56 and M.P.E.P. § 2001.06 speak for themselves. Plaintiff otherwise denies the allegations of Paragraph 20 of Defendants' Counterclaims.

21. Plaintiff admits the allegations of Paragraph 21 of Defendants' Counterclaims.

22. Plaintiff admits the allegations of Paragraph 22 of Defendants' Counterclaims.

23. Plaintiff admits the allegations of Paragraph 23 of Defendants' Counterclaims.

24. With respect to Paragraph 24 of Defendants' Counterclaims, Plaintiff denies that it knowingly withheld material information from the United States Patent and Trademark Office during prosecution of the '017 Patent. Plaintiff denies that it violated 37 C.F.R. § 1.56 or M.P.E.P. § 2001.06(c). Plaintiff admits that its trial counsel for the litigation referenced in Paragraphs 21 through 22 was aware of that litigation. Plaintiff denies the remainder of the allegations in Paragraph 24.

COUNTERCLAIM X

25. Plaintiff denies the allegations of Paragraph 25 of Defendants' Counterclaims.

26. With respect to the allegations of Paragraph 26 of Defendants' Counterclaims, Plaintiff states only that 37 C.F.R. § 1.56 speaks for itself. Plaintiff otherwise denies the allegations of Paragraph 26 of Defendants' counterclaims.

27. With respect to Paragraph 27 of Defendants' Counterclaims, Plaintiff denies that it knowingly withheld material information from the United States Patent and Trademark Office during prosecution of the '986 Patent. Plaintiff denies that it violated 37 C.F.R. § 1.56. Plaintiff denies that Plaintiff and/or Plaintiff's counsel was aware of German Patent No. 3,840,440 at any time during the prosecution of any of the patents-in-suit. Plaintiff denies that German Patent No. 3,840,440 contains any material or non-cumulative teachings and/or information. Plaintiff denies that Merchant & Gould represents or has represented the patentee for the German Patent in various patent matters. Plaintiff admits only that at some point in time, attorneys from Merchant & Gould prosecuted a design patent owned by the patentee of German Patent No. 3,840,440. Plaintiff denies that it failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during the prosecution of the '986 Patent. Plaintiff admits only that a copy of German Patent No. 3,840,440 was not provided to the United States Patent and Trademark Office during the prosecution of the '986 Patent.

COUNTERCLAIM XI

28. Plaintiff denies the allegations of Paragraph 28 of Defendants' Counterclaims.

29. With respect to the allegations of Paragraph 29 of Defendants' Counterclaims, Plaintiff states only that 37 C.F.R. § 1.56 speaks for itself. Plaintiff otherwise denies the allegations of Paragraph 29 of Defendants' Counterclaims.

30. With respect to Paragraph 30 of Defendants' Counterclaims, Plaintiff states only that 37 C.F.R. § 1.56 and M.P.E.P. § 2001.06 speak for themselves. Plaintiff denies the allegations of Paragraph 30 of Defendants' Counterclaims.

31. Plaintiff admits the allegations of Paragraph 31 of Defendants' Counterclaims.

32. Plaintiff admits the allegations of Paragraph 32 of Defendants' Counterclaims.

33. Plaintiff admits the allegations of Paragraph 33 of Defendants' Counterclaims.

34. Plaintiff admits the allegations of Paragraph 34 of Defendants' Counterclaims.

35. Plaintiff admits the allegations of Paragraph 35 of Defendants' Counterclaims.

36. With respect to Paragraph 36 of Defendants' Counterclaims, Plaintiff denies that it knowingly withheld material information from the United States Patent and Trademark Office during prosecution of the '986 Patent. Plaintiff denies that it violated 37 C.F.R. § 1.56 or M.P.E.P. § 2001.06(c). Plaintiff admits that its trial counsel for the litigation referenced in Paragraphs 31 through 34 was aware of that litigation. Plaintiff denies the remainder of the allegations in Paragraph 36.

AFFIRMATIVE DEFENSES

1. Defendants' Counterclaims fail to state a claim on which relief can be granted.

2. Defendants' Counterclaims alleging unenforceability of Plaintiff's patents due to inequitable conduct fail to meet the particularity requirements of Fed. R. Civ. P. 9(b).

3. United States Patent No. 5,365,690 meets all conditions for patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and it complies with the requirements of 35 U.S.C. §§ 112 and 116 and other applicable statutory sections.

4. United States Patent No. 5,365,690 is enforceable.

5. United States Patent No. 5,505,017 meets all conditions for patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and it complies with the requirements of 35 U.S.C. §§ 112 and 116 and other applicable statutory sections.

6. United States Patent No. 5,505,017 is enforceable.

7. United States Patent No. 6,493,986 B1 meets all conditions for patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and it complies with the requirements of 35 U.S.C. §§ 112 and 116 and other applicable statutory sections.

8. United States Patent No. 6,493,986 B1 is enforceable.

WHEREFORE, in addition to the relief requested in Plaintiff's Complaint, Plaintiff prays for an Order dismissing Defendants' Counterclaims with prejudice, and for such other and further relief as the Court may deem just and appropriate.

ECOLAB INC.,

by its attorneys,

DATE: December 30, 2004

s/Rachel K. Zimmerman

Douglas J. Williams, Reg. No. 117,353

Rebecca A. Bortolotti, Reg. No. 309,631

Rachel K. Zimmerman, Reg. No. 314,171

Rachel Clark Hughey, Reg. No. 328,042

MERCHANT & GOULD P.C.

3200 IDS Center

80 South Eighth Street

Minneapolis, Minnesota 55402-2215

Telephone: 612.332.5300

OF COUNSEL:

Andrew Sorensen, Esq.

ECOLAB INC.

Ecolab Center

370 North Wabasha Street

St. Paul, Minnesota 55102

telephone: 651.293.2432

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